

ESTTA Tracking number: **ESTTA668256**

Filing date: **04/22/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213597
Party	Plaintiff Caterpillar, Inc.
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Date	04/22/2015
Attachments	2015.04.22 Declaration of Laura K. Johnson ISO Opposition to Motion for Sanctions.pdf(991653 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>CATERPILLAR INC.,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>TIGERCAT INTERNATIONAL INC.,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No. 91213597</p> <p>Application Serial No. 85/591,967</p> <p>Mark: TIGERCAT</p> <p>Application date: April 8, 2012</p>
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**DECLARATION OF LAURA K. JOHNSON IN SUPPORT OF
OPPOSER CATERPILLAR INC.'S BRIEF IN OPPOSITION TO
APPLICANT TIGERCAT INTERNATIONAL INC.'S
MOTION FOR SANCTIONS AND SUSPENSION OF PROCEEDINGS**

I, Laura K. Johnson, declare as follows:

1. I am employed as an attorney with the law firm of Finnegan, Henderson, Farabow, Garrett, & Dunner, LLP ("Finnegan"), counsel of record for Opposer Caterpillar Inc. ("Caterpillar") in this proceeding. The facts set forth in this Declaration are based upon my personal knowledge and/or records obtained from the U.S. Patent and Trademark Office ("PTO") or from Caterpillar.
2. Following issuance of the Board's February 4, 2015 Order, to identify responsive discovery, Finnegan immediately contacted and began coordinating with a individuals within Caterpillar associated with various departments, including Legal, Global Sales, Customer Insights, Marketing, Global Brand Marketing, and Global Brand Management. Finnegan also examined its own internal Caterpillar records.
3. After compiling and validating comprehensive information from these sources, Caterpillar served Opposer's Supplemental Objections and Responses to Applicant's First Set of

Interrogatories; and Opposer's Amended and Supplemental Objections and Responses to Applicant's First Set of Request for Production of Documents on March 6, 2015. Caterpillar's Responses are attached hereto as Exhibits A and B. Caterpillar also produced more than 2,000 pages worth of documents, including representative license agreements, coexistence agreements, sales reports, market research and consumer study documents, style guides, and a list of trademark applications containing "cat" that Caterpillar had received in the last four years.

4. Caterpillar's continued its investigation into the existence of responsive documents after March 6, 2015. These efforts involved contacting additional individuals and departments within Caterpillar.

5. As a result of these continued efforts, Caterpillar produced eight documents on April 3, 2015 that consisted of 8,000 pages of documents, including its most recent trademark dilution searches from 2012 (referencing all pending applications and current or former registrations containing "cat"), and market surveys and protocols. Caterpillar also supplemented its Interrogatory No. 12 response.

6. On April 2, 2014, Caterpillar informed Tigercat that it would be producing additional responsive documents following its April 3, 2015 productions. As a result of its ongoing discovery efforts, Caterpillar produced a combined 27 additional documents on April 13, 2015 and April 21, 2015. These documents consisted of 1,100 pages and were largely comprised of market research and consumer studies.

7. True and correct copies of excerpts from the March 6, 2015, April 3, 2015, and April 13, 2015 productions are referenced in the brief along with their corresponding bates number. These documents are largely marked TRADE SECRET/COMMERCIALY SENSITIVE. Included in these excerpts is CAT021234 identifying a 96% consumer awareness

for the CAT mark in the United States. Also included in these excerpts is CAT021451 identifying that more than 80% of relevant consumers and purchasers in the United States perceive the CAT brand to be associated with Caterpillar.

8. On April 10, 2015, Tigercat produced approximately 1,300 pages of discovery, nearly tripling its production volume to date. All but twenty of these production documents are publicly-available website printouts, news articles, brochures, and photographs, despite Caterpillar's requests for market research and surveys and sales and advertising figures.

9. On April 13, 2015, Tigercat also served Caterpillar with additional Requests for Production and Requests for Admissions.

10. On April 21, 2015, Caterpillar produced its second supplemental response to Interrogatory Nos. 9 and 11. Caterpillar's response is attached hereto at Exhibit C. Caterpillar's response explained in narrative form the contents of its April 3, 2015, April 13, 2015, and April 21, 2015 productions.

11. To date, Caterpillar has produced more than 11,000 pages of documents in response to the Board's Order. This brings Caterpillar's production volume to 22,294 pages (by contrast Tigercat has produced less than 2,000 documents in this proceeding). Production efforts in regards to Tigercat's Discovery Requests are complete, to the extent currently known to Caterpillar, and Caterpillar knows of no additional representative documents responsive to these requests. Caterpillar remains committed to produce any additional relevant materials to the extent that these materials become available.

12. Caterpillar's European trademark counsel undertook studies evaluating consumers' familiarity with the CAT branded in Finland and Sweden. Caterpillar's European counsel produced these studies in the European Union Trademark Opposition between the

parties. Neither Caterpillar nor its U.S. trademark counsel undertook counterpart studies in the U.S. or any U.S. surveys.

13. On April 14, 2015, Finnegan contacted attorneys for Tigercat regarding a 120-day extension of the discovery schedule. On April 16, 2015, Tigercat's counsel informed Finnegan that it was willing to consent to a 30-day extension.

14. Attached as Exhibit D to this declaration is a copy of *Caterpillar Inc. v. Telescan Techs.*, 2002 WL 1301304 (C.D. Ill. Feb. 13, 2002).

15. Attached as Exhibit E to this declaration is a copy of *Converse Inc. v. Worldwide Kids Assocs.*, 2004 WL 950919 (T.T.A.B. Apr. 29, 2004).

16. Attached as Exhibit F to this declaration is a copy of *Jewelers Vigilance v. Piper Mgmt.*, 2004 WL 882090 (T.T.A.B. Apr. 20, 2004).

17. Attached as Exhibit G to this declaration is a copy of *General Motors Corp. v. Integrated Concepts & Research*, 2005 TTAB LEXIS 125 (T.T.A.B. Mar. 9, 2005).

18. Attached as Exhibit H to this declaration is a copy of *Chesapeake Bank v. Chesapeake Bank of Maryland*, 2004 WL 240313 (T.T.A.B. Feb. 5, 2004).

I declare under penalty of perjury that the foregoing is true and correct pursuant to 28 U.S.C. § 1746.

Dated: April 22, 2015

Respectfully submitted,

/Laura K. Johnson/
Laura K. Johnson

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing DECLARATION OF LAURA K. JOHNSON IN SUPPORT OF OPPOSER CATERPILLAR INC.'S BRIEF IN OPPOSITION TO APPLICANT TIGERCAT INTERNATIONAL INC.'S MOTION FOR SANCTIONS AND SUSPENSION OF PROCEEDINGS was served via electronic mail upon counsel for Applicant, on April 22, 2015.

/Jenny Macioge Reilly/
Case Manager

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>CATERPILLAR INC.,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>TIGERCAT INTERNATIONAL INC.,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No. 91213597</p> <p>Application Serial No. 85/814,584</p> <p>Mark: TIGERCAT</p> <p>Application date: January 3, 2013</p>
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**OPPOSER’S SUPPLEMENTAL OBJECTIONS AND
RESPONSES TO APPLICANT’S FIRST SET OF INTERROGATORIES**

Caterpillar Inc. (“Opposer”) hereby objects and responds to Tigercat International Inc.’s (“Applicant”) First Set of Interrogatories.

GENERAL OBJECTIONS

1. Opposer objects to Applicant’s discovery requests to the extent that they seek information that falls within the attorney-client privilege, that constitutes attorney work product, or that constitutes trial preparation material on the grounds that matter within the attorney-client privilege is outside the scope of permissible discovery and that attorney work product and trial preparation material, absent an appropriate showing, fall outside the scope of permissible discovery.
2. Opposer objects to Applicant’s discovery requests to the extent they seek discovery from third parties.
3. Opposer objects to Applicant’s discovery requests to the extent they seek to impose obligations beyond those required by the Federal Rules of Civil Procedure.

4. Opposer objects to Applicant's discovery requests to the extent they seek information that is neither relevant to this proceeding nor reasonably calculated to lead to the discovery of admissible evidence.

5. Opposer objects to Applicant's discovery requests to the extent they seek information that is not within Opposer's possession, custody, or control; to the extent that the information is in the public domain and equally available to Applicant; or to the extent that the information is already in Applicant's possession.

6. Opposer objects to Applicant's discovery requests to the extent they are unreasonably broad, unduly burdensome, oppressive, vague or ambiguous.

7. Opposer's written responses are based on information presently available to and located by Opposer and its attorneys. As Opposer has not completed its investigation of the facts relating to this case, its discovery in this action, or its preparation for trial, Opposer's written objections and written responses are made without prejudice to its right to supplement or amend its written objections and written responses and to present evidence discovered hereafter at trial.

8. To the extent that specific general objections are cited herein in response to specific discovery requests, those specific objections are provided because they are believed to be particularly applicable to the discovery requests and are not to be construed as a waiver of any other general objection applicable to information and documents falling within the scope of the request. Moreover, the production of any non-relevant information, whether or not in response to any discovery requests, is not to be construed as a waiver of a claim of irrelevancy.

RESPONSES TO INTERROGATORIES

INTERROGATORY NO. 1:

Identify the person(s) most knowledgeable about:

- (a) the use of Opposer's Marks on each and every one of Opposer's Goods and Services;
- (b) the advertising, promotion and sale of Opposer's Goods and Services under Opposer's Marks; and
- (c) the creation of all style guides for use of Opposer's Marks.

RESPONSE TO INTERROGATORY NO. 1:

Opposer objects to this request to the extent that it seeks to impose obligations beyond those required by the Federal Rules of Civil Procedure, the Trademark Rules of Practice, and/or the TBMP by requesting that Opposer identify employees beyond those who have relevant information upon which Opposer may rely in this proceeding. Opposer further objects to this request as the term "style guides" is vague, ambiguous and indefinite because it has not been defined. Subject to these objections and the general objections above, Opposer identifies Ed Stembridge, Product Identity Manager at Caterpillar, Inc., 100 NE Adams Street, Peoria, IL 61629-9240 as the person most knowledgeable about subpart (a) and (c) and Ed Stembridge and Michael Duncan, Industry Manager, Caterpillar Forest Products, 100 NE Adams Street, Peoria, IL 61629-9240 as the person most knowledgeable about subpart (b).

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 1:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Ed Stembridge is the person's most knowledgeable about subpart (b), namely advertising, promotion, and sale of Opposer's Goods and Services under Opposer's Marks.

INTERROGATORY NO. 3:

Identify all feline imagery Opposer uses in connection with the sale and offering for sale of Opposer's Goods.

RESPONSE TO INTERROGATORY NO. 3:

Opposer objects to this interrogatory to the extent it covers information that is irrelevant to this proceeding. Opposer further objects to this interrogatory as overly broad and unduly burdensome to the extent that it seeks sales information outside the United States. Moreover, Opposer objects to the phrase "feline imagery" as vague, ambiguous, and indefinite because it has not been defined. Opposer additionally objects to this interrogatory as overly broad and unduly burdensome to the extent that it requests information spanning the life of Opposer's products. Subject to these objections and the general objections above, Opposer has several brands, including CAT, CAT FINANCIAL, CAT REMAN, CAT RENTAL STORE, ANCHOR COUPLING, ASIATRAK, FG WILSON, HALCO, HINDUSTAN, HYPAC, MAK, MWM, OLYMPIAN, PERKINS, PRENTICE, PROGRESS RAIL, PYROBAN, SEM, ZHENGZHOU, SIWEI, SOLAR TURBINES, TURBOMACH, TURNER POWERTRAIN SYSTEMS and UNIT RIG. The CAT brand is the cornerstone of the Caterpillar brand portfolio, representing products and services made by Caterpillar. In 1949, "Cat" began appearing on machine trade dress. Over time, the level of familiarity with the CAT brand made it possible to rely on it as a primary public-facing brand name. Thus, "Cat" and development of the CAT brand were not based on the use of feline imagery and have not relied upon feline imagery in conjunction with the sale or offer for sale of Opposer's Goods. Nevertheless, Caterpillar is

commonly referred to as “Big Cat” by third-parties and in media references. Significantly, various media outlets have made widespread, unsolicited use of the “Big Cat” nickname to refer to Caterpillar and/or its products, from prominent print publications like the Washington Post, Los Angeles Times, and Chicago Tribune, to television and radio programs such as CNBC News. And because Caterpillar is regarded as a bellweather with respect to the economy, it is commonly referred to as “Big Cat” by the media and others in the financial world. A tiger is obviously a type of “Big Cat.”

A representative summary of the unsolicited media uses of the “Big Cat” nickname—which stretches back over *twenty years*—appears in the chart below.

Publication	Date	Publication Text
Associated Press	March 18, 1989	A few years ago, Peoria-based Caterpillar, like the U.S. steel industry, was on the industrial critical list. ... Big Cat battled back by restructuring factory floors, forging a new relationship with workers, and looking for every possible way to lower costs and stay competitive in the world marketplace.
Chicago Sun-Times	October 30, 1992	BIG CAT SALE: Caterpillar Inc. took another step toward recapturing its Asian markets Thursday with a deal to sell 295 large bulldozers to a Russian natural gas company.
Chicago Tribune	March 3, 1994	HEADLINE: CATERPILLAR MAKES MARK IN FOOTWEAR BODY: The Big Cat has put its best foot forward in signing a licensing deal with the maker of Hush Puppies.
Newsday	September 12, 1996	HEADLINE: LAIR OF THE BIG CAT GRAPHIC: AP Photo—Lair of the Big Cat . Visitors attending Mine Expo International in Las Vegas crane for a look at a huge Caterpillar earthmover.

Publication	Date	Publication Text
Automotive News	March 24, 1997	<p>Caterpillar has developed a new 600-horsepower engine that it says will help trucking companies keep their drivers. ...</p> <p>The 600-hp engine won't be in full production until January 1998, but it already has been dubbed "The Big Cat 600" by drivers and others aware of its development.</p>
Fort Worth Star-Telegram	August 6, 1997	<p>The Stolen Big Cat. It was slow, it was yellow, and it weighed 25 tons. But someone still took it—a Caterpillar track loader—early yesterday from a highway construction site on Northeast Loop 820.</p>
Engineering News-Record	November 10, 1997	<p>HEADLINE: SMALL MACHINES FOR THE BIG CAT</p> <p>BODY: Caterpillar Inc. is throwing its very large hardhat into the small equipment ring. The Peoria, Ill.-based manufacturer plans to manufacture compact wheel loaders and mini hydraulic excavators in Europe early next year...</p>
Omaha World Herald	May 2, 1998	<p>It's as wide as a downtown street, big as a bungalow and heavier than some Army tanks. Friday, the Lexion combine harvester was on display in downtown Omaha, as Caterpillar Claas America announced plans to mass produce the machine in Sarpy County. Secretary of State Scott Moore, who was on hand for the announcement, called it simply the "Big Cat."</p>
The Times Union	July 18, 1999	<p>HEADLINE: Big Cat learns to think small</p> <p>BODY: Big as in earth-movers that crawl across the ground like Titans and are used to gut mountains. ...But now Caterpillar, the world's biggest maker of heavy equipment, is thinking small. ...In May, the Peoria-based manufacturer began shipping a new line of compact equipment...</p>
Journal and Courier	March 12, 2000	<p>GRAPHIC: BIG CAT IN TOWN: Caterpillar Inc. is the world's biggest maker of heavy equipment and operates the Large Engine Center plant in Lafayette.</p>
Plain Dealer	November 1, 2000	<p>The humans have brought in the big beasts to take back the shoreline. ...</p> <p>At the bottom, the Big Cat waited—Mike Huffman Jr.'s Caterpillar 330 L. The Big Cat had the task of carefully and precisely positioning the rocks along the 315-foot long shoreline erosion-control area.</p>

Publication	Date	Publication Text
Investor's Business Daily	August 19, 2003	Big Cat Purring Take machinery firm Caterpillar, whose shares are up 25% since a blowout earnings report on July 17.
Investor's Business Daily	April 21, 2005	"Big Cat" Smashes, Raises Views Caterpillar earned \$1.63 a share, up 37% vs. a year ago and 27 cents over Q1 views.
Investor's Business Daily	June 9, 2005	Earlier, Prudential upgraded Caterpillar, saying it should easily beat profit forecasts due to strong volume. Big Cat was one of the best Dow components on Wed.
Investor's Business Daily	June 22, 2005	Big Cat jumps on analyst report Caterpillar gained 1.5% to 102.20 after Lehman Bros. said a meeting with the firm's management increased the brokerage's confidence that margins will improve in the second half of '05 and in '06.
Business Wire	May 16, 2006	The Big CAT Grows Caterpillar (NYSE: CAT) announced plans to acquire Progress Rail, a railroad industry supplier...
The San Francisco Chronicle	November 7, 2006	About 4 a.m. on Oct. 30, Richmond firefighters responded to the site to put out what was left of a Caterpillar 320 excavator... The Big Cat was burned so completely it had to be disassembled to be moved.
Investor's Business Daily	June 21, 2007	Shares of industry leader Caterpillar hit a new high in early trading Wednesday before reversing for modest losses. ... Big Cat's shares are up nearly 35% so far this year.
Associated Press Online	February 18, 2011	BIG CAT: Caterpillar Inc. rose 2.4 percent to lead the Dow.
Benzinga.com	April 28, 2011	Caterpillar is set to report earnings tomorrow morning, and the whole world will be watching "Big Cat," as its excavators, cranes, and bulldozers are used throughout the world.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 3:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Caterpillar is not aware of any use of "feline imagery" in conjunction with the sale or offer for sale of Opposer's Goods. Caterpillar's brand usage guidelines have been produced at CAT011423-CAT011740.

Third parties independently refer to Caterpillar as "Big Cat." *See* CAT012903-CAT012928, website printouts from <http://www.fool.com/investing/general/2012/10/26/why-you-should-listen-to-the-big-cat-roar.aspx>; <http://www.vistapglobal.com/2014/01/a-vista-partners-commentary-the-big-cat-caterpillar-cat-reports-is-hungry-again-surges-5-14-today/>; <https://www.mitsubishi.com/mpac/e/monitor/back/0606/news.html>; <http://stockdesk.com/the-big-cat-roars-back/>; <http://www.waste-management-world.com/articles/print/volume-15/issue-5/features/big-cat-on-the-prowl-in-paris.html>; <http://www.constructionweekonline.com/article-12357-dragons-on-the-hunt-for-big-cat-game/>; and <http://marketchess.com/2015/02/27/trapping-big-cat-with-a-chase-chess-moves>. Viewing the articles in context, this association and terminology reflects Caterpillar's leadership, success and superiority in the products it manufactures, the industries it serves, and in its role in the global economy.

To emphasize this association, these articles often reference "Big Cat" or Caterpillar with indicia attributable to a large feline, like a tiger. *See, e.g.*, "The Big Cat roars;" "the Big Cat is hungry again;" "the Big Cat purrs;" and "the Big Cat roars back." The following illustration, depicting Caterpillar as a tigercat, further demonstrates this connection:

27
FEB
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EST

Trapping the Big Cat with a Chase; Chess Moves



I just went short the giant global industrial player, Caterpillar, at \$83.03, with a protective cover-stop over \$86. This position amounts to roughly 4% of my trading portfolio capital.

The big CAT has been weak on the whole since around Thanksgiving of last year. But that weakness has been covered up by the chase happening in the market at-large.

See <http://marketchess.com/2015/02/27/trapping-big-cat-with-a-chase-chess-moves>.

The public's association with Caterpillar and the "Big Cat" name is not limited to electronic and print news media. It is also evidenced in music. Ellis and Wince Coles, Canadian musicians known for their ballads about sheep and other animals, also wrote a song about a Caterpillar machine entitled *Big Cat 9*.

Again, while the references relate to Caterpillar's success and leadership, Opposer believes they further foster a likelihood of confusion between the "Tigercat" name and the CAT mark.

INTERROGATORY NO. 8:

Identify five (5) representative purchasers for each of Opposer's Goods and Services sold under Opposer's Marks during the last five (5) years.

RESPONSE TO INTERROGATORY NO. 8:

Opposer objects to the interrogatory as overly broad and unduly burdensome to the extent that it requests identification of purchasers for "each of Opposer's Goods and Services."

Opposer objects to this interrogatory as overly broad and unduly burdensome to the extent that it seeks information outside the United States. Subject to these objections and the general objections above, for at least the last five years, each of Opposer's Goods and Services have been sold to individuals, businesses, and governments through the www.cat.com, www.parts.cat.com, www.catrentalstore.com, catused.cat.com, www.shopcaterpillar.com websites, catalogs containing CAT goods and services, and Opposer's independently owned and operated network of Caterpillar dealers. From there the independent dealers sell the goods and services to customers.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 8:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

A number of the goods and services identified in Opposer's Registrations have applications in multiple industries. For example, Opposer's off road industrial vehicles, parts, and services related thereto are typically sold through Caterpillar's network of independent CAT dealers to purchasers involved in the forestry, agriculture, construction, and mining industries, to name a few. Moreover, Caterpillar's logistics, consultation, and warehousing services

coordinate delivery of a wide variety of products to Caterpillar dealers and the individual customers. Accordingly, Opposer has identified the general types of purchasers for goods and services within each industry.

The general types of purchasers for Opposer's Goods and Services in the forestry industry include businesses involved in road building and clearing, harvesting and felling, lumber extraction, lumber processing and loading; millyard processing, and reforestation.

The general types of ultimate purchasers for Opposer's Goods and Services in the agriculture industry include agricultural producers involved in the clearing of aerial and ground areas, the planting, tilling, plowing, spraying, irrigating and harvesting activities for crops, the mowing, harvesting, and baling of hay, and the wide variety of other activities that take place on a farm. These end users vary in size from individual farmers to large producers in the agricultural market.

The general types of ultimate purchasers for Opposer's Goods and Services in the construction industry include individuals, contractors, businesses, and local, state, and federal government agencies involved in construction projects including building and road (grading, soil stabilizing, cold planning, soil or asphalt compaction) construction and maintenance.

The general types of ultimate purchasers for Opposer's Goods and Services in the mining industry include businesses involved in the drilling, digging and cutting of materials, moving and hauling of material; and maintenance of efficient mine sites.

The general types of ultimate purchasers of Opposer's Goods and Services in the landscaping industry including individuals, contractors, businesses, and local, state and federal government agencies involved in landscape design & build, irrigation, soil preparation, sod installation, tree installation, nurseries or snow & ice management activities.

The general types of ultimate purchasers for Opposer's Goods and Services in the demolition and recycling industry include businesses and local, state and federal government agencies involved in demolition, material handling, waste compaction, scrap recycling, barge and truck loading, and waste transferring.

The general types of ultimate purchasers for Opposer's on-highway vehicles, parts, and services related thereto, include individuals, businesses, and local, state, and federal government agencies purchasing trucks with hauling and towing needs. These vehicles may be used as dump trucks, concrete mixers, waste carriers, or heavy haulers.

The general types of ultimate purchasers for Opposer's lift truck goods, parts, and related services include businesses involved in diverse commercial and industrial operations that have materials handling needs. These materials include everything from boxes, to crates, to concrete pipes.

INTERROGATORY NO. 9:

Identify all market research and consumer studies done by or on behalf of Opposer or any third party related to Opposer's Marks since 2000.

RESPONSE TO INTERROGATORY NO. 9:

Opposer objects to this Request to the extent it is duplicative of Interrogatory No. 11. Opposer objects to this interrogatory as overly broad and unduly burdensome to the extent that "all market research and consumer studies . . . related to Opposer's Marks" covers information and documents that are irrelevant to this proceeding. Opposer also objects to this interrogatory to the extent that it seeks information covered by the attorney-client privilege or the work-product doctrine. Opposer objects to the terms "market research" and "consumer studies" as vague, ambiguous, and indefinite because they have not been defined.

Notwithstanding this objection, to the extent this interrogatory is understood, Opposer will produce non-privileged research considered responsive to this request.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 9:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Annually and quarterly Caterpillar produces its state of the brand reports providing information regarding Caterpillar's brand portfolio, consumer recognition of the Caterpillar brands, and steps being taken to strength and grow the Caterpillar brands. These documents have been produced at CAT010931-CAT011022, CAT011074, CAT011166-CAT011242.

Further, Caterpillar has run a number of internal surveys addressing initial customer purchases and product use. These surveys are conducted by a third-party on Caterpillar's behalf and contact customers of Opposer's Goods that were purchased through Caterpillar dealers. The studies assess customer satisfaction, with the objective of indicating to Opposer how it can improve its products and customer relationships. While the surveys cover a wide number of Opposer's Goods, customers are broken down by industry or particular market segment. As part of these surveys, customers are asked questions regarding Opposer's brands, customer's brand loyalty, and competitors within the respective marketplaces. Documents related to these surveys have been produced at CAT011023-CAT011073, CAT011089, CAT011165..

INTERROGATORY NO. 11:

Identify all market research and consumer studies done by or for Opposer or by any third party related to the fame or recognition or awareness of Opposer's Marks since 2000.

RESPONSE TO INTERROGATORY NO. 11:

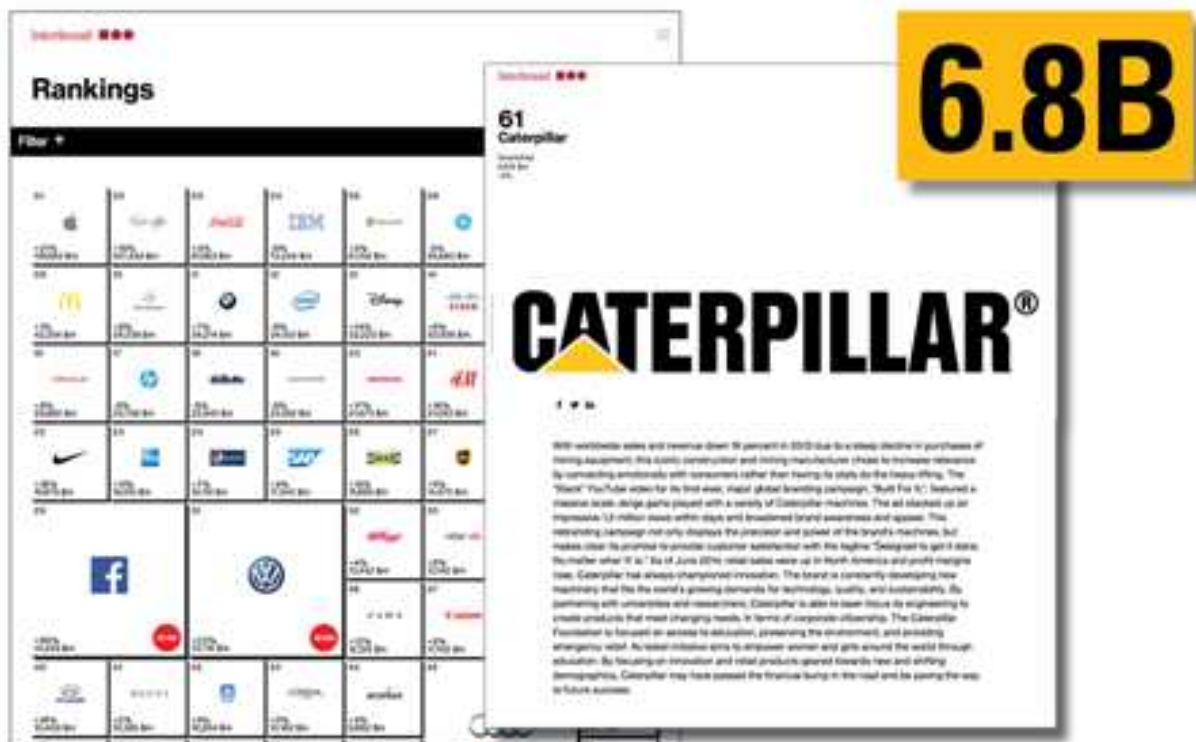
Opposer objects to this interrogatory as overly broad and unduly burdensome to the extent that “all market research and consumer studies” covers information and documents that are irrelevant to this proceeding. Opposer also objects to this interrogatory to the extent that it seeks information covered by the attorney-client privilege or the work-product doctrine. Moreover, Opposer objects to the terms “market research” and “consumer studies” as vague, ambiguous, and indefinite because they have not been defined. Notwithstanding this objection, to the extent this interrogatory is understood, Opposer will produce such non-privileged research considered responsive to this request.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 11:

Subject to the objections and responses in Opposer’s Objections and Responses to Applicant’s First Set of Interrogatories and pursuant to the limitations set forth in the Board’s February 4, 2015 Order, Opposer supplements its response to this request as follows.

A number of third-party brand studies are conducted each year identifying the world’s best known or most valuable brands, including for example Interbrand, Fortune, and Forbes. For example, Caterpillar has been named as a Fortune 100 company for years, including as No. 49 on the 2014 Fortune 500 list. Moreover, Fortune named Caterpillar #28 in the World’s Most Admired Companies for 2015. Forbes named Caterpillar #57 in the World’s Most Valuable Brands for 2014. Since at least 2004, Caterpillar has been ranked in Interbrand’s best global brand report identifying the top 100 brands. *See, e.g.*, CAT011090-CAT011164. The following is an excerpt from the 2014 Interbrand study -

Caterpillar ranks **61st** amongst the 100 most valuable brands.



Relying upon this widespread marketplace acknowledgement of its consumer recognition and fame, Opposer has not separately conducted any surveys regarding the fame of the Opposer's Marks in the last five years.

INTERROGATORY NO. 12:

Identify all third party uses of "CAT" as a mark or name or component of a mark or name or domain name in connection with any goods or services identified in Opposer's Registrations.

RESPONSE TO INTERROGATORY NO. 12:

Opposer objects to this request to the extent it seeks information that is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Information about marks that have not been asserted by Opposer in this proceeding and about arguments Opposer

may have made with respect to those marks in other proceedings has no bearing on any issue in this case. *See Chicago Bears Football Club, Inc. v. 12th Man/Tennessee LLC*, 83 U.S.P.Q.2d 1073 (T.T.A.B. 2007) (The fact that the CHICAGO BEARS did not sue fan Web sites that used its name had no relevance to its opposition to registration of the mark 12th BEAR for fan jewelry, clothing, and the like. A likelihood of confusion was found.). Opposer further objects to this interrogatory to the extent that it seeks information covered by the attorney-client privilege or the work-product doctrine. Opposer further objects to this interrogatory on the ground it seeks information that is publicly available and equally available to Applicant.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 12:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Opposer has utilized a trademark watch service for the CAT and CATERPILLAR marks for a number of years. A summary of references to third-party applications incorporating "cat" for the last three years has been produced at CAT011741-CAT012902. Regarding common law references, Caterpillar routinely objects to the third parties who make use of Opposer's Marks or similar marks and names. Over the last five years, some of these parties have included:

Disputed Mark	Owner
CAT REBUILT	DB Supply Company, Inc.
CAT YELLOW	Amazing Trailers, Inc.
WILDKAT ATTACHMENTS & Design	Mid-State Equipment LLC
MINECAT	Industrial Fabrication Inc.
PROCAT	Puma North America, Inc.
CAT Spindle	CAT Spindle Grinding Services
Caterpillar Crash Pad	Brooks Sports, Inc.
CAT Construction Company	CAT Construction Co., LLC

Caterpillar has reached an amicable resolution with each of these parties. Additionally, Caterpillar is aware that opposing parties have attached third party websites as exhibits in several opposition proceedings involving the CAT or CATERPILLAR marks. Caterpillar can neither confirm nor deny the authenticity of these websites. Finally, as discussed in detail in its Supplemental Response to Interrogatory Nos. 3, a number of third parties utilize the term “Big Cat” to reference Opposer or Opposer’s Goods and Services.

INTERROGATORY NO. 16:

Describe in detail each occasion when anyone has inquired of Opposer whether Applicant and Opposer are affiliated or otherwise related.

RESPONSE TO INTERROGATORY NO. 16:

Opposer objects to this interrogatory to the extent it calls for information protected from disclosure by the attorney-client privilege and/or work product doctrine. Opposer also objects to this interrogatory as overly broad and unduly burdensome in that it requests identification of “each occasion” such communications, which could information that is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects to this interrogatory as premature to the extent that Opposer’s investigations are ongoing and that discovery is still ongoing, and Opposer reserves the right to supplement its response to this interrogatory. Subject to this objection, and the general objections above, and without waiving any claims of privilege or work product, as Applicant knows, Opposer initiated this proceeding because of Applicant’s apparent plans to expand its rights beyond the forestry field and its resulting concern that such plans would create a likelihood of consumer confusion.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 16:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

At this time, Caterpillar is not aware of any instances where customers have inquired as to whether Opposer and Applicant are affiliated or otherwise related. Caterpillar's search for instances of consumer confusion is ongoing, particularly pertaining to Applicant's apparent plans to expand its rights beyond the forestry field, as such plans likely suggest to others that Tigercat is affiliated with Caterpillar or authorized by Caterpillar to use the CAT mark beyond forestry and related vegetation management fields. To the extent that customers are not yet aware of Tigercat's intention to offer goods outside of the forestry field, it is unsurprising that Caterpillar has yet to uncover instances of customer confusion. If Caterpillar becomes aware of such instances before the close of discovery, it will supplement this response.

INTERROGATORY NO. 18:

State in dollars and units the sales for each of Opposer's Goods and Service sold under Opposer's Marks for each calendar year since 2009.

RESPONSE TO INTERROGATORY NO. 18:

Opposer objects to this interrogatory to the extent it seeks to impose obligations on Opposer greater than those required under the Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") because it asks Caterpillar to state annual revenues in both units and dollars. Opposer further objects to this interrogatory as overly broad, unduly burdensome and beyond the scope of discovery to the extent that it seeks sales information outside the United States. As Opposer sells products through the Caterpillar

Dealer Network, Opposer also objects to this interrogatory to the extent it calls for the production of information that is not kept by Opposer in the ordinary course of business or readily ascertainable based on a review of Opposer's business records. Further, because the products and services offered under Opposer's CAT Marks are frequently sold together with other products offered by Opposer, separate sales information for the products and services offered under Opposer's CAT Marks may not be readily ascertainable. Subject to these objections and the general objections above, Opposer's annual sales and revenues for 2009 - 2013 were:

<i>Dollars in millions</i>					
Years	2013	2012	2011	2010	2009
Sales and revenues	\$55,656	\$65,875	\$60,138	\$42,588	\$32,396
Percent inside the United States	33%	31%	30%	32%	31%

To the extent that sales information is available for Opposer's individual Goods and Services sold under the CAT Marks, Opposer will produce such documents.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 16:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Caterpillar has produced sales information in both dollars and units sold for Opposer's Goods and Services from 2009 - 2014, as such information is kept in the ordinary course of business at CAT012929.

Dated: March 6, 2015

Respectfully submitted,

/Christopher P. Foley/

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing OPPOSER'S OBJECTIONS AND RESPONSES TO APPLICANT'S FIRST SET OF INTERROGATORIES was served via e-mail and FedEx, upon counsel for Applicant, on March 6, 2015:

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Litigation Legal Assistant

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>CATERPILLAR INC.,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>TIGERCAT INTERNATIONAL INC.,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No. 91213597</p> <p>Application Serial No. 85/814,584</p> <p>Mark: TIGERCAT</p> <p>Application date: January 3, 2013</p>
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**OPPOSER’S AMENDED AND SUPPLEMENTAL OBJECTIONS AND RESPONSES TO
APPLICANT’S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS**

Caterpillar Inc. (“Opposer”) hereby objects and responds to Tigercat International Inc.’s (“Applicant”) First Set of Requests for Production of Documents.

GENERAL OBJECTIONS

1. Opposer objects to Applicant’s discovery requests to the extent that they seek information that falls within the attorney-client privilege, that constitutes attorney work product, or that constitutes trial preparation material on the grounds that matter within the attorney-client privilege is outside the scope of permissible discovery and that attorney work product and trial preparation material, absent an appropriate showing, fall outside the scope of permissible discovery.

2. Opposer objects to Applicant’s discovery requests to the extent they seek information that constitutes confidential, highly confidential business, or trade secret/commercially sensitive information. Opposer will provide such information and documents in accordance with the terms of the Board’s Standardized Protective Order effective August 31, 2007.

3. Opposer objects to Applicant's discovery requests to the extent they seek discovery from third parties.

4. Opposer objects to Applicant's discovery requests to the extent they seek to impose obligations beyond those required by the Federal Rules of Civil Procedure.

5. Opposer objects to Applicant's discovery requests to the extent they seek information that is neither relevant to the claims or defenses of any party nor reasonably calculated to lead to the discovery of admissible evidence.

6. Opposer objects to Applicant's discovery requests to the extent they seek information that is not within Opposer's possession, custody, or control; to the extent that the information is in the public domain and equally available to Applicant; or to the extent that the information is already in Applicant's possession.

7. Opposer objects to Applicant's discovery requests to the extent they are unreasonably broad, unduly burdensome, oppressive, vague or ambiguous.

8. Opposer's written responses are based on information presently available to and located by Opposer and its attorneys. As Opposer has not completed its investigation of the facts relating to this case, its discovery in this action, or its preparation for trial, Opposer's written objections and written responses are made without prejudice to its right to supplement or amend its written objections and written responses and to present evidence discovered hereafter at trial.

10. To the extent that specific general objections are cited herein in response to specific discovery requests, those specific objections are provided because they are believed to be particularly applicable to the discovery requests and are not to be construed as a waiver of any other general objection applicable to information and documents falling within the scope of the

request. Moreover, the production of any non-relevant information, whether or not in response to any discovery requests, is not to be construed as a waiver of a claim of irrelevancy.

RESPONSES TO DOCUMENT REQUESTS

REQUEST NO. 14:

Documents sufficient to identify each occasion when anyone has inquired of Opposer whether Applicant and Opposer are affiliated or related.

RESPONSE TO REQUEST NO. 14:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks “each occasion” (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer also objects to this request to the extent it calls for information protected from disclosure by the attorney-client privilege and/or work product doctrine. Subject to the above general and specific objections, as Applicant knows, Opposer initiated this proceeding because of Applicant’s apparent plans to expand its rights beyond the forestry field and its resulting concern that such plans would cause consumer confusion. Accordingly, Opposer will produce responsive, relevant, and non-privileged documents.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 14:

Subject to the objections and responses in Opposer’s Objections and Responses to Applicant’s First Set of Requests for Production of Documents and Things, Opposer supplements its response to this request as follows.

At this time, Caterpillar is not aware of any non-privileged, relevant, and responsive documents. Caterpillar’s search for responsive documents is ongoing, particularly pertaining to Applicant’s apparent plans to expand its rights beyond the forestry field as such plans likely

suggest to others that Tigercat is affiliated with Caterpillar or authorized by Caterpillar to use the CAT mark beyond forestry and related vegetation management fields. To the extent that Caterpillar becomes aware of responsive documents before the close of discovery, it will produce them.

REQUEST NO. 16:

All documents referring or relating to Applicant and/or Applicant's Mark.

AMENDED RESPONSE TO REQUEST NO. 16:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "all documents" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery to the extent that it seeks documents relating to the Applicant or Applicant's Marks as opposed to the particular products that are the subject of the opposed application, which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer also objects to this request to the extent that it seeks information subject to attorney-client and attorney-work-product privileges. Opposer further objects to this request as overly broad, unduly burdensome, and beyond the scope of discovery to the extent that it seeks documents about Applicant or Applicant's Marks from outside of the United States. Moreover, as Applicant knows, Opposer initiated this proceeding because of Applicant's apparent plans to expand its rights beyond the forestry field. Opposer first became aware of this plan through Applicant's filing of the application, which is being opposed. Therefore, Opposer objects to this request to the extent it

seeks information predating the filing date of this Application. Subject to the above general and specific objections, Opposer will produce responsive, relevant, and non-privileged documents.

REQUEST NO. 19:

All documents referring or relating to any licenses for Opposer's Marks.

RESPONSE TO REQUEST NO. 19:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "all documents" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer objects to this request to the extent that it seeks documents covered by the attorney-client privilege or the work-product doctrine. Opposer also objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery to the extent it is not limited by time. Opposer further objects to this request to the extent that it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "any licenses for Opposer's Marks" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. For the purposes of its response, Opposer will produce licenses for Opposer's Marks for goods or services in the forestry and vegetation management fields to the extent such documents exist. Subject to the above general and specific objections, Opposer will produce responsive, relevant, and non-privileged documents.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 19:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Requests for Production of Documents and pursuant to the limitations set

forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Opposer has produced a representative sample of license agreements entered into in the last five years that involve Opposer's Marks. Moreover, Opposer has produced a form Trademark and Service Mark Agreement that is utilized in drafting agreements with perspective licensees, including Caterpillar dealers.

REQUEST NO. 20:

All documents referring or relating to any coexistence agreements related to or referring to Opposer's Marks.

RESPONSE TO REQUEST NO. 20:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "all documents" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer objects to this request to the extent that it seeks documents covered by the attorney-client privilege or the work-product doctrine. Opposer also objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery to the extent it is not limited by time. Opposer further objects to this request to the extent that it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "any coexistence agreements related to or referring to Opposer's Marks" (emphases added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. For the purposes of its response, Opposer will produce coexistence agreements for Opposer's Marks for goods or services in the forestry and vegetation

management fields to the extent such documents exist. Subject to the above general and specific objections, Opposer will produce responsive, relevant, and non-privileged documents.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 20:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Requests for Production of Documents and pursuant to the limitations set forth in the Board's February 4, 2015 order, Opposer supplements its response to this request as follows.

Opposer has produced a representative sample of coexistence agreements entered into in the last five years that involve Opposer's Marks. For a number, if not all, of these coexistence agreements, the Applicants agreed to withdraw their pending U.S. trademark applications and were permitted to continue use of their proposed marks, normally with a design component.

REQUEST NO. 21:

All documents referring or relating to any consent agreements related to or referring to Opposer's Marks.

RESPONSE TO REQUEST NO. 21:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "all documents" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer objects to this request to the extent that it seeks documents covered by the attorney-client privilege or the work-product doctrine. Opposer also objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery to the extent it is not limited by time. Opposer further objects to this request to the extent that it

is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks “any consent agreements related to or referring to Opposer’s Marks” (emphases added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. For the purposes of its response, Opposer will produce consent agreements for Opposer’s Marks for goods or services in the forestry and vegetation management fields to the extent such documents exist. Subject to the above general and specific objections, Opposer will produce responsive, relevant, and non-privileged documents.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 21:

Subject to the objections and responses in Opposer’s Objections and Responses to Applicant’s First Set of Requests for Production of Documents and pursuant to the limitations set forth in the Board’s February 4, 2015 order, Opposer supplements its response to this request as follows.

Opposer has identified no consent agreements involving Opposer’s Marks entered into in the last five years.

REQUEST NO. 24:

All documents referring or relating to all market research and consumer studies done by or on behalf of Opposer or any third party related to Opposer’s Marks since 2000.

RESPONSE TO REQUEST NO. 24:

Opposer objects to this request to the extent that it is duplicative of Request No. 27. Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks “all documents referring or relating to all market research and consumer studies documents” (emphases added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer also

objects to this request to the extent that it seeks information and documents subject to the attorney-client privilege or the work-product doctrine. Moreover, Opposer objects to the terms “market research” and “consumer studies” as vague, ambiguous, and indefinite because they have not been defined. Subject to and without waiving its general and specific objections and to the extent that it understands this request, Opposer will produce representative responsive, relevant, and non-privileged documents.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 24:

Subject to the objections and responses in Opposer’s Objections and Responses to Applicant’s First Set of Requests for Production of Documents and pursuant to the limitations set forth in the Board’s February 4, 2015 Order, Opposer supplements its response to this request as follows.

Opposer has produced a representative sample of market and research studies conducted in the last five years that involve Opposer’s Marks.

REQUEST NO. 26:

All documents referring or relating to purchaser recognition of Opposer’s Marks since 2000.

RESPONSE TO REQUEST NO. 26:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks “all documents” (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer also objects to this request to the extent that it seeks information and documents subject to the attorney-client privilege or the work-product doctrine. Moreover, Opposer objects to the term “purchaser recognition” as vague, ambiguous, and indefinite because

it has not been defined. Subject to and without waiving its general and specific objections and to the extent that it understands this request, Opposer will produce representative responsive, relevant, and non-privileged documents to the extent such documents exist.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 26:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Requests for Production of Documents and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Opposer has produced a representative sample of documents involving purchaser recognition for Opposer's Marks dated within the last five years.

REQUEST NO. 27:

All documents referring or relating to all market research and consumer studies done by or for Opposer or by any third party related to the fame or recognition or awareness of Opposer's Marks since 2000.

RESPONSE TO REQUEST NO. 27:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "all documents" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer objects to this request as overly broad, unduly burdensome, and beyond the scope of discovery to the extent it seeks "all market research and consumer studies" covering information and documents that are irrelevant to this proceeding. Opposer also objects to this request to the extent that it seeks information and documents subject to the attorney-client privilege or the work-product doctrine. Moreover, Opposer objects to the terms "market research" and "consumer studies" as vague, ambiguous, and indefinite because they have not

been defined. Opposer further objects to this request to the extent it seeks documents outside Opposer's care, custody or control. Subject to and without waiving its general and specific objections and to the extent that it understands this request, Opposer will produce representative responsive, relevant, and non-privileged documents.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 27:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Requests for Production of Documents and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Opposer has produced a representative sample of documents related to the recognition or awareness of Opposer's Marks dated within the last five years.

REQUEST NO. 28:

All documents referring or relating to consumer recognition of Opposer's Marks since 2000.

RESPONSE TO REQUEST NO. 28:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "all documents" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer also objects to this request to the extent that it seeks information and documents subject to the attorney-client privilege or the work-product doctrine. Moreover, Opposer objects to the term "consumer recognition" as vague, ambiguous, and indefinite because it has not been defined. Subject to and without waiving its general and specific objections and to

the extent that it understands this request, Opposer will produce representative responsive, relevant, and non-privileged documents to the extent such documents exist.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 28:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Requests for Production of Documents and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Opposer has produced a representative sample of documents related to consumer recognition of Opposer's Marks dated within the last five years.

REQUEST NO. 29:

All style guides for use of Opposer's Marks.

RESPONSE TO REQUEST NO. 29:

Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery in that it seeks "all style guides" (emphasis added), which could include documents that are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Opposer objects to this request to the extent it is overbroad, unduly burdensome, and beyond the scope of discovery to the extent it is not limited by time. Opposer also objects to this request to the extent that it seeks information and documents subject to the attorney-client privilege or the work-product doctrine. Opposer further objects to this request as the term "style guides" is vague, ambiguous and indefinite because it has not been defined. Subject to and without waiving its general and specific objections and to the extent that it understands this request, Opposer will produce representative responsive, relevant, and non-privileged documents to the extent such documents exist.

SUPPLEMENTAL RESPONSE TO REQUEST NO. 29:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Requests for Production of Documents and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Opposer has produced documents delineating the brand guidelines and standards of use for the CATERPILLAR and CAT trademarks in a variety of mediums.

Dated: March 6, 2015

Respectfully submitted,

/Christopher P. Foley/

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing OPPOSER'S AMENDED AND SUPPLEMENTAL OBJECTIONS AND RESPONSES TO APPLICANT'S FIRST SET REQUESTS FOR PRODUCTION OF DOCUMENTS was served e-mail and FedEx, upon counsel for Applicant, on March 6, 2015:

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/Kristin M. Creed/
Litigation Legal Assistant

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>CATERPILLAR INC.,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>TIGERCAT INTERNATIONAL INC.,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No. 91213597</p> <p>Application Serial No. 85/814,584</p> <p>Mark: TIGERCAT</p> <p>Application date: January 3, 2013</p>
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**OPPOSER’S SECOND SUPPLEMENTAL OBJECTIONS AND
RESPONSES TO APPLICANT’S FIRST SET OF INTERROGATORIES (NOS. 9 and 11)**

Caterpillar Inc. (“Opposer”) hereby objects and responds to Tigercat International Inc.’s (“Applicant”) First Set of Interrogatories.

GENERAL OBJECTIONS

1. Opposer objects to Applicant’s discovery requests to the extent that they seek information that falls within the attorney-client privilege, that constitutes attorney work product, or that constitutes trial preparation material on the grounds that matter within the attorney-client privilege is outside the scope of permissible discovery and that attorney work product and trial preparation material, absent an appropriate showing, fall outside the scope of permissible discovery.
2. Opposer objects to Applicant’s discovery requests to the extent they seek discovery from third parties.
3. Opposer objects to Applicant’s discovery requests to the extent they seek to impose obligations beyond those required by the Federal Rules of Civil Procedure.

4. Opposer objects to Applicant's discovery requests to the extent they seek information that is neither relevant to this proceeding nor reasonably calculated to lead to the discovery of admissible evidence.

5. Opposer objects to Applicant's discovery requests to the extent they seek information that is not within Opposer's possession, custody, or control; to the extent that the information is in the public domain and equally available to Applicant; or to the extent that the information is already in Applicant's possession.

6. Opposer objects to Applicant's discovery requests to the extent they are unreasonably broad, unduly burdensome, oppressive, vague or ambiguous.

7. Opposer's written responses are based on information presently available to and located by Opposer and its attorneys. As Opposer has not completed its investigation of the facts relating to this case, its discovery in this action, or its preparation for trial, Opposer's written objections and written responses are made without prejudice to its right to supplement or amend its written objections and written responses and to present evidence discovered hereafter at trial.

8. To the extent that specific general objections are cited herein in response to specific discovery requests, those specific objections are provided because they are believed to be particularly applicable to the discovery requests and are not to be construed as a waiver of any other general objection applicable to information and documents falling within the scope of the request. Moreover, the production of any non-relevant information, whether or not in response to any discovery requests, is not to be construed as a waiver of a claim of irrelevancy.

INTERROGATORY NO. 9:

Identify all market research and consumer studies done by or on behalf of Opposer or any third party related to Opposer's Marks since 2000.

RESPONSE TO INTERROGATORY NO. 9:

Opposer objects to this Request to the extent it is duplicative of Interrogatory No. 11.

Opposer objects to this interrogatory as overly broad and unduly burdensome to the extent that "all market research and consumer studies . . . related to Opposer's Marks" covers information and documents that are irrelevant to this proceeding. Opposer also objects to this interrogatory to the extent that it seeks information covered by the attorney-client privilege or the work-product doctrine. Opposer objects to the terms "market research" and "consumer studies" as vague, ambiguous, and indefinite because they have not been defined.

Notwithstanding this objection, to the extent this interrogatory is understood, Opposer will produce non-privileged research considered responsive to this request.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 9:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

Annually and quarterly Caterpillar produces its state of the brand reports providing information regarding Caterpillar's brand portfolio, consumer recognition of the Caterpillar brands, and steps being taken to strength and grow the Caterpillar brands. These documents have been produced at CAT010931-CAT011022, CAT011074, CAT011166-CAT011242.

Further, Caterpillar has run a number of internal surveys addressing initial customer purchases and product use. These surveys are conducted by a third-party on Caterpillar's behalf

and contact customers of Opposer's Goods that were purchased through Caterpillar dealers. The studies assess customer satisfaction, with the objective of indicating to Opposer how it can improve its products and customer relationships. While the surveys cover a wide number of Opposer's Goods, customers are broken down by industry or particular market segment. As part of these surveys, customers are asked questions regarding Opposer's brands, customer's brand loyalty, and competitors within the respective marketplaces. Documents related to these surveys have been produced at CAT011023-CAT011073, CAT011089, CAT011165..

SECOND SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 9:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer further supplements its response to this request as follows.

Caterpillar, itself or through contracted research companies, conducts a variety of market research and consumers studies related to the CAT and CATERPILLAR brands and products sold thereunder. Moreover, Caterpillar utilizes market research studies conducted by third parties, evaluating the strength of the CAT and CATERPILLAR brands. These research categories include the following (with the corresponding production numbers identified) -

REDACTED

REDACTED

INTERROGATORY NO. 11:

Identify all market research and consumer studies done by or for Opposer or by any third party related to the fame or recognition or awareness of Opposer's Marks since 2000.

RESPONSE TO INTERROGATORY NO. 11:

Opposer objects to this interrogatory as overly broad and unduly burdensome to the extent that "all market research and consumer studies" covers information and documents that are irrelevant to this proceeding. Opposer also objects to this interrogatory to the extent that it seeks information covered by the attorney-client privilege or the work-product doctrine.

Moreover, Opposer objects to the terms "market research" and "consumer studies" as vague, ambiguous, and indefinite because they have not been defined. Notwithstanding this objection,

to the extent this interrogatory is understood, Opposer will produce such non-privileged research considered responsive to this request.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 11:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer supplements its response to this request as follows.

A number of third-party brand studies are conducted each year identifying the world's best known or most valuable brands, including for example Interbrand, Fortune, and Forbes. For example, Caterpillar has been named as a Fortune 100 company for years, including as No. 49 on the 2014 Fortune 500 list. Moreover, Fortune named Caterpillar #28 in the World's Most Admired Companies for 2015. Forbes named Caterpillar #57 in the World's Most Valuable Brands for 2014. Since at least 2004, Caterpillar has been ranked in Interbrand's best global brand report identifying the top 100 brands. *See, e.g.*, CAT011090-CAT011164. The following is an excerpt from the 2014 Interbrand study -

REDACTED

Caterpillar ranks **61st** amongst the 100 most valuable brands.



Relying upon this widespread marketplace acknowledgement of its consumer recognition and fame, Opposer has not separately conducted any surveys regarding the fame of the Opposer's Marks in the last five years.

SECOND SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 11:

Subject to the objections and responses in Opposer's Objections and Responses to Applicant's First Set of Interrogatories and pursuant to the limitations set forth in the Board's February 4, 2015 Order, Opposer further supplements its response to this request as follows.

Opposer's counsel has not conducted any market research or consumer study specifically evaluating fame of the CAT or CATERPILLAR marks from a trademark perspective. Further,

unlike the Finland and Poland studies produced to Tigercat in the counterpart European proceeding, Opposer's counsel has not conducted studies evaluating consumer familiarity or associations with CAT mark.

That being said, as identified in connection with its Second Supplemental Response to Interrogatory No. 9, Caterpillar and third parties have conducted the following studies measuring brand awareness and consumer perception of the CAT or CATERPILLAR marks -

REDACTED

Dated: April 21, 2015

Respectfully submitted,

/Christopher P. Foley/

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Attorneys for Opposer
Caterpillar Inc.

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing OPPOSER'S SECOND SUPPLEMENTAL OBJECTIONS AND RESPONSES TO APPLICANT'S FIRST SET OF INTERROGATORIES (NOS. 9 AND 11) was served via e-mail, upon counsel for Applicant, on April 21, 2015:

CANDACE LYNN BELL
ECKERT SEAMANS CHERIN & MELLOTT LLC
50 S 16TH STREET, 22ND FLOOR
PHILADELPHIA, PA 19102-2523

/Laura K. Johnson/

Laura K. Johnson

EXHIBIT D



KeyCite Yellow Flag - Negative Treatment

Distinguished by [Prosperity Bancshares, Inc. v. Town and Country Financial Corp.](#), C.D.Ill., February 5, 2013

2002 WL 1301304

Only the Westlaw citation is currently available.

United States District Court, C.D. Illinois.

CATERPILLAR INC., Plaintiff,

v.

TELESCAN TECHNOLOGIES, L.L.C., Defendant.

No. CIV.A. 00-1111. | Feb. 13, 2002.

FINAL JUDGMENT[MCDADE, J.](#)**I. INTRODUCTION**

*1 Plaintiff, Caterpillar, Inc. (“Caterpillar”), filed this action on March 21, 2000, against defendant, TeleScan Technologies, L.L.C. (“TeleScan”) to prevent TeleScan’s use of the CATERPILLAR and CAT word and design marks as trademarks and domain names in connection with heavy equipment and related services. TeleScan’s counsel withdrew representation in this matter. Since a corporation cannot

appear in court other than through its attorneys, [Scandia Down Corp. v. Euroquilt, Inc.](#), 772 F.2d 1423, 1427 (7th Cir.1985), the Court directed TeleScan to retain substitute counsel. TeleScan, however, has failed to do so. On January 16, 2001, the Court issued an entry of default. Pursuant to that entry of default, the Court enters the following:

II. FINDINGS OF FACT

Caterpillar has for many years been a globally known, multi-national manufacturer and distributor of large, earthmoving, mining and construction equipment (“heavy equipment”) as well as a provider of repair and maintenance services for that equipment. Complaint, ¶ 4. Over a period of many years, Caterpillar has generated and maintained substantial valuable goodwill in its corporate operations and its trademarks. This goodwill has been generated and sustained through Caterpillar’s many business operations. Complaint, ¶ 5.

Since long prior to the acts of TeleScan that form the subject of this suit, Caterpillar adopted and has continuously used the inherently distinctive marks CATERPILLAR and CAT, and the design marks CATERPILLAR and CAT (the “Caterpillar Marks”) in connection with its heavy equipment goods and services. Complaint, ¶ 6. Caterpillar owns numerous federal registrations for the Caterpillar Marks, including the following:

Mark	Goods/Services	First Use in Commerce	Reg. No.	Registration Date
Caterpillar	Tractors, tractor engines, track links, track shoes, grousers, grease guns, agricultural machinery tools and equipment, road construction and maintenance machinery tools and equipment, and the parts for all said goods.	9/00/04	277,417	11/11/30
Caterpillar	Tractors adapted to be employed in farming operations, road building, mining, logging, earth moving, hauling and for other industrial and agricultural purposes.	9/00/04	345,499	4/27/37
Caterpillar	Dump wagons, wheel tractor-sump-wagon combinations, and	00/00/41	506,258	2/1/49

	structural parts for such products.			
Caterpillar	diesel engines for marine purposes; cable-control units for controlling cable actuated equipment associated with tractors and the like	1/00/39	531,626	10/10/50
Caterpillar	Tires	9/30/70	955,141	3/13/73
Caterpillar (Design)	Lift trucks and engines, attachments, and parts.	9/00/70	985,439	6/4/74
CAT (Design)	Maintenance and repair services in the field of internal combustion engines, vehicles and power equipment, namely, trucks, tractors, engines, earthmoving equipment, material handling equipment, paving equipment, agricultural equipment, generators, and control units for the aforementioned	10/20/88	1,579,438	1/23/90
Caterpillar (Design)	Machinery for earth moving, earth conditioning and material handling, namely, loaders and engines therefor, and parts for vehicle and internal combustion engines.	10/20/88	2,140,605	3/3/98
CAT (Design)	Machinery for earth moving, earth conditioning and material handling namely, loaders and engines therefor, and parts for vehicle and internal combustion engines; vehicles for earth and material hauling and handling, namely, tractors and engines therefor	10/20/88	2,140,606	3/3/98

*2 These registrations are valid and subsisting, are owned by Caterpillar, and Registration numbers 277,417, 345,499, 506,258, 531,626, 955,141, 985,439, and 1,579,438 have become incontestable pursuant to [15 U.S.C. §§ 1065 and 1115\(b\)](#). Complaint, ¶ 8–9.

Caterpillar has spent many millions of dollars advertising its heavy equipment goods and services under the Caterpillar Marks through a wide variety of channels of trade, including the Internet. Caterpillar has sold hundreds of millions of dollars worth of Caterpillar branded heavy equipment and services through a network of licensed, authorized dealers. These licensed dealers sell both used and new Caterpillar

heavy equipment. Complaint, ¶ 10. Caterpillar's extensive advertising and sales have resulted in the Caterpillar Marks becoming some of the most recognized and famous of marks in the United States and represent extraordinarily valuable goodwill owned by Caterpillar. Complaint, ¶ 11; see Stephen P. Smith, *America's Greatest Brands: An Insight Into 80 of America's Strongest Brands* (2001).

To sell and promote its heavy equipment, Caterpillar owns many domain names and has active web sites at the domain names www.cat.com and www.caterpillar.com ("Caterpillar web sites"). The Caterpillar web sites represent a considerable investment by Caterpillar and form an important part of its marketing strategy. They provide information regarding Caterpillar's goods and services, including new and used equipment sales and rentals. The sites also include a Dealer Locator, which allows consumers to search for a dealership located in a certain area and to search for dealers in their area who stock a specific piece of Caterpillar equipment. Complaint, Exhibit F.

Caterpillar selected, registered, and uses the domain names www.cat.com and www.caterpillar.com because of the fame and goodwill associated with its Caterpillar Marks and the assumptions that internet users make about domain names in searching for particular branded goods, services or web sites. Internet users generally will assume that a domain name that consists of a famous mark is associated with or sponsored by the owner of that mark. *Ty, Inc. v. Agnes M.*, 2001 U.S. Dist. Lexis 18852 at *20–21 (N.D.Ill. Nov. 13, 2001); *Ford Motor Co. v. Ford Financial Solutions*, 103 F.Supp.2d 1126, 1128 (N.D.Iowa 2000); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir.1999). Based upon this assumption, some internet users will begin their search for a web site by typing in a famous trademark or company name followed by a top-level domain, like ".com." Internet users also may type in famous trademarks or company names plus some descriptive variant like "products" or "equipment," and then followed by a top-level domain. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1045 (9th Cir.1999). For example, users seeking the web site for Ford Motor Company may type in the domain name www.Ford.com or www.Fordtrucks.com. Consumers will use this method to find web sites because they believe that the owner of ford.com or fordtrucks.com is associated with Ford Motor Company, the original equipment manufacturer.

*3 Caterpillar claims that several domain names registered by TeleScan infringe upon Caterpillar's rights in the Caterpillar Marks. TeleScan has registered over 50 domain names that contain famous marks of various companies like John Deere, General Motors, Toyota, and Peterbilt. Complaint, ¶ 20. Among those registrations are six domain names that are comprised of the Caterpillar Marks: catusedequipment.com; catnewequipment.com; caterpillarusedequip.com; caterpillarnewequip.com; caterpillarequipment.com; caterpillardealers.com (collectively, the "disputed domain names"). Complaint, ¶ 12. TeleScan registered the disputed domain names without Caterpillar's consent and with full knowledge of Caterpillar's long prior use and ownership of the Caterpillar Marks. Complaint, ¶ 15 and 18. Four of these disputed domain names resolved to web pages that welcomed visitors to the "Caterpillar Used Equipment Website," the "Caterpillar New Equipment Website," the "Caterpillar Equipment Website," and the "Caterpillar Dealers Website" ("disputed web sites"). Each of these pages also purported to be "A Listing Service for Caterpillar Equipment." Complaint, ¶ 13.

TeleScan intends to use the disputed domain names to promote its services and direct traffic to its web site at www.heavyscan.com web site that will contain a listing of the heavy equipment inventories of subscribing dealers. Complaint, ¶ 12. In a manner similar to Caterpillar's online Dealer Locator, consumers could search the listings by dealer. Consumers also could search the listings by company to locate dealers who sell new and used equipment manufactured by that desired company.¹ Complaint, ¶ 12–13. By using the Caterpillar Marks in this way, TeleScan is trading upon Caterpillar's goodwill and reputation and giving the disputed web sites a notoriety and salability they might not otherwise obtain.

1

Telescan already maintains a web site at truckscan.com that has a searchable listing of new and used trucks. As in the current matter, Telescan linked a number of domain names that contained famous third party trademarks to the truckscan.com web site. This practice was challenged in *PACCAR, Inc. v. TeleScan Technologies, L.L.C.*, 115 F.Supp.2d 772, 780 (E.D.Mich.2000), and the court found that TeleScan's use of Paccar's domain names that contained famous marks to direct traffic to the truckscan.com web site constituted trademark infringement.

III. CONCLUSIONS OF LAW

Pursuant to 15 U.S.C. §§ 1065 and 1115, Caterpillar's registrations and use of its Caterpillar Marks confirm the validity of Caterpillar's exclusive right to use the Caterpillar Marks in connection with the goods and services specified in those registrations. This exclusive right empowers Caterpillar to enjoin any third party use of a mark that is likely to cause confusion with the Caterpillar Marks. 15 U.S.C. §§ 1114 and 1116.

The disputed domain names are likely to cause consumer confusion especially considering that they contain some of the most famous marks in America—the Caterpillar marks—and that TeleScan intends to use them to sell actual Caterpillar equipment. See *Trans Union LLC v. Credit Research, Inc.*, 142 F.Supp.2d 1029, 1042 (N.D.Ill.2001); *Paccar*, 115 F.Supp.2d at 778. This situation is aggravated by how people use the Internet. Many people may assume that the disputed domain names are sponsored by or associated with Caterpillar because they contain the Caterpillar Marks. *Ty, Inc. v. Agnes M.*, 2001 U.S. Dist. Lexis 18852 at *20–21 (N.D.Ill. Nov. 13, 2001); *Ford Motor Co. v. Ford Financial Solutions*, 103 F.Supp.2d 1126, 1128 (N.D.Iowa 2000); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir.1999). The fact that the domain names also contain a term that describes the types of products Caterpillar sells will not change this assumption. TeleScan exploits this incorrect assumption and has increased the likelihood that consumers will believe the web sites are associated with Caterpillar by welcoming visitors to the web sites with phrases such as “Caterpillar Used Equipment Website” and by purporting to be “A Listing Service for Caterpillar.”

*4 In sum, visitors looking at the disputed web sites may mistakenly believe that the web sites are affiliated with Caterpillar when they see the Caterpillar Marks in the domain names and on the sites and also see a listing of Caterpillar products. By using the Caterpillar Marks in this way, TeleScan is trading upon the goodwill and fame associated with the Caterpillar Marks for its own profit. This constitutes trademark infringement. At least one court has already ruled that TeleScan's use of third party marks in domain names constitutes trademark infringement. In *Paccar v. TeleScan, Inc.*, the Eastern District of Michigan ruled that TeleScan's use of Paccar's marks in several different domain names for web sites that sell Paccar

products constituted trademark infringement. 115 F.Supp.2d 772 (E.D.Mich.2000). Furthermore, the purpose for which TeleScan registered the disputed domain names and the manner in which TeleScan intends to use the disputed domain names and the Caterpillar Marks also constitutes bad faith. Due to this finding of bad faith which makes this an exceptional case under the Lanham Act, Caterpillar is entitled to its attorney fees related to this action. *Sanderson v. Spectrum Labs, Inc.*, 248 F.3d 1159 (7th Cir.2000); *BASF Corp. v. Old World Trading Co.*, 41 F.3d 1081, 1099 (7th Cir.1994).

The fact that TeleScan has placed disclaimers on the web sites does not alleviate the likelihood that consumers will believe that the web sites are associated with Caterpillar. First, disclaimers normally are ineffective. *Simon Prop. Group, L.P. v. MySimon, Inc.*, 2001 U.S. Dist. LEXIS 852 at *63–64 (N.D.Ill. Jan. 24, 2001). Second, even if the disclaimers are effective, they will not cure the problem of initial interest confusion. *Id.* Internet based initial interest confusion “occurs when customers seeking a particular web site are diverted by allegedly infringing domain names and metatags to a competing web site and then realize that the site they have accessed is not the one they were looking for, but nevertheless decide to use the offerings of the infringing site.” *Trans Union*, 142 F.Supp.2d at 1043–44. Thus, if a consumer logs onto the disputed web sites, he or she may eventually realize that the site is not sponsored by Caterpillar, and yet still purchase Caterpillar heavy equipment through the unauthorized dealers listed at the heavyscan.com web site. This type of initial interest confusion is a violation of Caterpillar's rights in the Caterpillar Marks. *Paccar v. TeleScan*, 115 F.Supp.2d 772, 778 (E.D.Mich.2000) (“A disclaimer that purports to disavow association with the trademark owner after the consumer has reached the site comes too late; the customer has already been misdirected. This problem, denoted as ‘initial interest confusion’ ... is a form of confusion protected by the Lanham Act.”)

TeleScan's use of the Caterpillar Marks also runs afoul of the Anticybersquatting Consumer Protection Act, which imposes liability upon a person who (1) uses a domain name that is identical or confusingly similar to a famous or distinctive mark and (2) uses that domain name a bad faith intent to profit. 15 U.S.C. § 1125(d)(1)(A). TeleScan fulfills both prongs of this test. First, the Caterpillar Marks are among the most famous marks currently used in United States commerce, and the disputed domain names are confusingly similar to the Caterpillar Marks. Second, TeleScan did have

a bad faith intent to profit from its use of the Caterpillar marks. Pursuant to 15 U.S.C. § 1125(d)(1)(B)(i)(VIII), this finding of bad faith can be inferred from the fact that TeleScan has no trademark rights to the Caterpillar Marks and that the disputed domain names were intended to divert traffic to TeleScan's www.heavyscan.com web site. Even more telling is the fact that TeleScan not only had registered multiple domain names which contain famous marks, but that at least one court had already found TeleScan's registration of domain names containing famous marks violated that Lanham Act. *Paccar v. TeleScan*, 115 F.Supp. 772 (E.D.Mich.2000); see *Nav-Aids Ltd. v. Nav-Aids USA, Inc.*, 2001 U.S. Dist. LEXIS 17619 at *25–25 (N.D.Ill. October 24, 2001) (finding that the registration of a domain name similar to plaintiff's mark was attempt to divert traffic and thus an indication of bad faith intent); 15 U.S.C. § 1125(d)(1)(B) (i)(VIII) (listing registration of multiple domain names which the person knows are confusingly similar to other's marks as a factor favoring a finding of bad faith); *Shields v. Zuccarini*, 254 F.3d 476, 485 (4th Cir.2001). Therefore, TeleScan's registration and use of the disputed domain names violates the Anticybersquatting Consumer Protection Act.

*5 TeleScan's use of the Caterpillar Marks also dilutes the distinctive quality of the Caterpillar Marks. Dilution is “the lessening of the capacity of a famous mark to identify and distinguish goods or services.” 15 U.S.C. § 1125; See *Agnes M.*, 2001 U.S. Dist. LEXIS at *45. Dilution occurs in cyberspace when a defendant's use “lessens the capacity of [the plaintiff] to identify and distinguish its goods and services by means of the Internet.” *Ty, Inc. v. Perryman*, 2001 U.S. Dist. LEXIS 10303, 2001 WL 826893, at *13. In the Seventh Circuit, it is unnecessary for the plaintiff to demonstrate actual economic harm, only a “likelihood of dilution based on the renown of its trademarks and the similarity between those marks and the allegedly diluting uses” of the defendant. *Agnes M. Ltd.*, 2001 U.S. Dist. LEXIS at *45. A defendant's use of plaintiff's marks as a domain name dilutes those marks because they diminish plaintiff's capacity to “identify and distinguish its goods by means of the Internet.” *Id.* at *46; *Paccar v. TeleScan*, 115 F.Supp.2d 772, 779–80 (E.D.Mich.2000) (holding that TeleScan's use of trademarks in domain names “ ‘dilutes’ the trademark by placing the trademark owner ‘at the mercy’ of the web site operator”). In this case, TeleScan's use of the Caterpillar Marks in the disputed domain names lessens Caterpillar's ability to identify its goods and services via the Internet.

The fair use doctrine, which renders lawful the merely descriptive use of others' marks, does not insulate TeleScan from liability. Just as an automobile repair shop may, without first obtaining authorization, advertise that it “repairs [plaintiff's] cars, [it] may not do so in a manner which is likely to suggest to his prospective customers that his is part of [plaintiff's] organization of franchised dealers and repairmen.” *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir.1969). Here, TeleScan's use of the Caterpillar Marks in the disputed domain names as well as on its associated web pages creates an impression that TeleScan is related to or sponsored by Caterpillar, and thus confuses the public about the source or sponsorship of TeleScan's goods and services. *Paccar v. TeleScan*, 115 F.Supp.2d 772, 779 (E.D.Mich.2000). This is the very type of confusion the Lanham Act is meant to prevent, and the very type of use that lies outside the umbrella of the fair use doctrine.

Nor is the first-sale doctrine a valid defense. The first-sale doctrine protects a trademarked-product reseller from infringement liability when use of the trademark is only “incidental to permissible resale and accompanying advertisement of trademarked products,” but the doctrine is not available to uses that “create confusion beyond mere resale...” *Enesco Corp. v. K's Merchandise Mart Inc.*, 56 U.S.P.Q.2d 1583 (N.D.Ill.2000); see *Sebastian Int'l v. Longs Drug Stores Corp.*, 53 F.3d 1073, 1076 (9th Cir.1995) (“When a purchaser resells a trademark article under the producer's trademark, and nothing more, there is no actionable misrepresentation under the statute,” but finding that use actionable when in “telephone directory advertising”, and “promotional literature”). Any conduct “beyond mere resale” triggers liability. For example, “active or purposeful deception, false suggestion, or misrepresentation on the part of a reseller, designed or likely to cause confusion about whether or not the reseller is an authorized dealer.” *Enesco*, 56 U.S.P.Q. at 1593. Indeed, the first sale doctrine flounders where the plaintiff manufacturer has an established network of authorized dealers and defendant's activity misleads consumers into thinking that defendant is part of that network. *Bernina of America, Inc. v. Fashion Fabrics Int'l, Inc.*, 2001 U.S. Dist. LEXIS 1211 at *5–6; 2001 WL 128164 (N.D.Ill. Feb. 9, 2001). Here, TeleScan's use of the Caterpillar Marks in the disputed domain names and the claims that the disputed web sites were “A Listing Service of Caterpillar Equipment” is likely to cause confusion beyond mere resale.

*6 TeleScan's verbatim incorporation of the Caterpillar Marks in the disputed domain names and use of the Caterpillar

Marks on the disputed web sites conveys an overall commercial impression that will confuse consumers into believing that the sites and services to be provided to them are approved, authorized, or otherwise endorsed by Caterpillar. TeleScan's use of the Caterpillar Marks in connection with heavy equipment and motor vehicle sales, advertising, or listing services and TeleScan's use of the Caterpillar Marks within the disputed domain names constitutes trademark infringement, unfair competition, dilution, and cybersquatting. Furthermore, TeleScan's registration of the disputed domain names and intent to use the domain names to direct traffic to its www.heavyscan.com web site constitutes bad faith and entitles Caterpillar to its attorney fees related to this action. For the above reasons, it is hereby ordered:

I. TeleScan, its assigns, agents, servants, affiliates, employees, attorneys, and representatives, and all those in privity with or acting through or in connection with TeleScan, including but not limited to Ron Thomas, are permanently enjoined from:

A. registering or maintaining registration of the disputed domain names, or any other domain names, trademarks, designations or symbols containing the Caterpillar Marks, in whole or in part, or that are confusingly similar to, or dilutive of, the Caterpillar Marks;

B. using the disputed domain names or any other domain names containing the Caterpillar Marks, in whole or in part, or that are confusingly similar to, or dilutive of, the Caterpillar Marks;

C. using any trademarks, designations or symbols containing the Caterpillar Marks, in whole or in part, or that are confusingly similar to, or dilutive of, the Caterpillar Marks on any of TeleScan's web sites or other promotional materials in a manner that is likely to give consumers the impression that TeleScan, TeleScan's goods or services, the disputed web sites or any other web sites owned by TeleScan are owned, associated with, or sponsored by Caterpillar;

D. claiming ownership of the disputed domain names or any other domain names, trademarks, designations or symbols containing the Caterpillar Marks, in whole or in part, or that are confusingly similar to, or dilutive of, the Caterpillar Marks

E. offering for sale the disputed domain names or any other domain names, trademarks, designations or symbols containing the Caterpillar Marks, in whole or in part, or

that are confusingly similar to, or dilutive of, the Caterpillar Marks;

F. transferring, to any person or entity, other than Caterpillar, the infringing domain names or any other domain names, trademarks, designations or symbols containing the Caterpillar Marks in whole or in part, or that are confusingly similar to, or dilutive of, the Caterpillar Marks;

G. doing any other act or thing likely to induce the belief that TeleScan's business or service is in any way legitimately connected with, sponsored by or approved by Caterpillar;

*7 H. doing any other act or thing likely to induce the belief that any web sites owned or registered by TeleScan are in any way legitimately connected with, sponsored by or approved by Caterpillar; and

I. doing any act or thing likely to dilute the distinctiveness of the Caterpillar Marks or likely to tarnish the goodwill associated with them.

II. TeleScan is directed to:

A. disclose to the Court and Caterpillar all other domain name registrations of domain names that contain in whole or part the Caterpillar Marks that are owned by TeleScan through any domain name registry, in order to permit the Court and Caterpillar to consider whether any such other registrations should be subject to relief in this matter.

B. transfer to Caterpillar the registrations in the disputed domain names and any other registrations as may be determined by this Court as appropriate for relief and with TeleScan to bear any costs associated with such transfer of ownership;

C. provide an accounting of all profits derived by TeleScan from its unlawful acts for the Court and Caterpillar to consider whether these profits should be paid to Caterpillar;

D. pay to Caterpillar all of the costs of this action;

E. pay to Caterpillar the \$7,5000 that the Court ordered TeleScan to pay to Caterpillar in its July 26, 2001 order;

F. pay to Caterpillar all of the attorney's fees expended in this action;

G. deliver up for destruction all labels, signs, brochures, prints, advertisements, and any other material of an

infringing, diluting tarnishing or unfair nature in TeleScan's possession or control as well as all means of making the same; and file with this Court and serve on Caterpillar within thirty (30) days after the entry of judgment a written report under oath setting forth in detail

the manner and form of TeleScan's compliance with the terms of this Court's order.

SO ORDERED AND ADJUDGED

End of Document

© 2015 Thomson Reuters. No claim to original U.S. Government Works.

EXHIBIT E

2004 WL 950919 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

CONVERSE INC.

v.

WORLDWIDE KIDS ASSOCIATES, LTD.

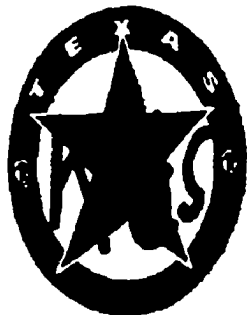
Opposition No. 91103997

April 29, 2004

*1 Before [Quinn](#), Bottorff, and [Rogers](#)
Administrative Trademark Judges

By the Board:

Worldwide Kids Associates, Ltd. (“applicant”) seeks to register TK TEXAS KIDS and design in the following form



for “footwear, headwear, and clothing for children, women, and men, namely, pants, shorts, shirts, blouses, skirts, jackets, overalls, warm-up suits, sweatshirts, socks, hats, leotards, and dresses” in International Class 25. ¹

Converse Inc. (“opposer”) has opposed registration of applicant's mark under Trademark Act Section 2(d), [15 U.S.C. Section 1052\(d\)](#), based on a claim of likelihood of confusion with its previously used and registered “family” of marks which include a star design. ²

This case now comes up for consideration of (1) opposer's consented motion (filed February 21, 2003) to extend discovery and trial dates; (2) opposer's third motion (filed February 27, 2003) for leave to amend its pleading; (3) opposer's combined motion (filed April 25, 2003) for summary judgment and for discovery sanctions under [Trademark Rule 2.120\(g\)\(1\)](#); and (4) Anthony Simon's request (filed July 16, 2003) to withdraw as opposer's counsel herein. Opposer's motion for leave to amend its pleading and its combined motion for summary judgment and for discovery sanctions have been fully briefed.

Mr. Simon's request to withdraw from this proceeding based on his resignation from the law firm of Thompson Coburn LLP is hereby granted. Matthew J. Himich of the law firm of Thompson Coburn LLP will continue as opposer's attorney of record herein.

Opposer's consented motion to extend discovery and trial dates is hereby granted to the extent modified in the discovery and trial schedule set forth *infra*. ³

Turning next to opposer's third motion for leave to amend its pleading herein, opposer seeks to amend its notice of opposition to add the following claims under Trademark Act Sections 1 and 45, [15 U.S.C. Sections 1051](#) and [1127](#):

15. Applicant owns Reg. No. 2,073,848 for retail store services featuring clothing, footwear and headwear for children, women, and men, gifts and accessories. The mark shown in Reg. No. 2,073,848 is the identical mark sought to be registered by Applicant in this Application.⁴

16. On information and belief, Applicant has closed its stores for which the mark shown in Reg. No. 2,073,848 pertains.

17. On information and belief, Applicant is no longer using the mark shown in Reg. No. 2,073,848.

*2 18. On information and belief, Applicant no longer licenses others to use the mark shown in Reg. No. 2,073,848.

19. On information and belief, Applicant has abandoned with the intent not to reuse the mark shown in Reg. No. 2,073,848.

20. On information and belief, Applicant[,] when it filed its Application [,] only intended to sell in its stores for which Reg. No. 2,073,848 pertains the goods listed [in] its Application which were made, licensed and sponsored by third parties and not Applicant.

21. On information and belief, Applicant never intended that the mark shown in the Application would be affixed to the goods listed in its Application, especially footwear.

22. Applicant never intended that the mark would be placed on containers for the goods listed in the Application.

23. Applicant never intended that the mark would be placed on displays for the goods listed in the Application.

24. On information and belief, Applicant when it filed its Application only intended that the mark shown in the Application would be used in connection with the operation of its stores for which Reg. No. 2,073,848 pertains.

25. On information and belief, Applicant never had or no longer has a bona fide intention of using the mark shown in Application Serial No. 74/632,112 for any of the goods listed in its application.

26. On information and belief, Applicant only intends to reserve rights in its mark shown in Reg. No. 2,073,848 and has discontinued all bona fide use of the mark in the ordinary trade.

27. On information and belief, Applicant did not intend that placing its mark on the goods listed in the Application would distinguish his goods from the similar goods of others, but rather Applicant only intended to indicate its store services when it filed its Application.

28. On information and belief, Applicant did not intend that placing its mark on the goods listed in the Application would indicate the source of the goods to others, but rather Applicant only intended to indicate its store services when it filed its Application.

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See [Fed. R. Civ. P. 15\(a\)](#); TBMP Section 507.02. Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Notwithstanding applicant's objections, which are largely based on the fact that opposer sought to raise the claims set forth in the third amended notice of opposition more than six years after the commencement of this proceeding, there is no evidence of prejudice to applicant beyond a relatively insignificant further delay in the resolution of this proceeding.

***3** With regard to the claims that opposer seeks to add by way of its third amended notice of opposition, we note that applicant's involved application is based on an assertion of a bona fide intent to use under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#). To the extent that opposer seeks to raise a claim of abandonment, such a claim is inappropriate in the context of an opposition to registration of a mark in an intent-to-use application because an intent-to-use applicant is not required to use its mark until it files its amendment to allege use or statement of use.⁵ See [Consolidated Cigar Corp. v. Rodriguez](#), 65 USPQ2d 1153 (TTAB 2002). Accordingly, the proposed claim of abandonment that opposer seeks to raise by way of paragraph Nos. 15-19 cannot be raised in this proceeding and is hereby stricken.

With regard to opposer's proposed claim regarding applicant's alleged lack of a bona fide intent to use the mark in commerce, however, the Board finds that the allegations set forth in paragraph Nos. 20-28 of the third amended notice of opposition constitute adequate notice pleading of a claim that applicant has no bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#).

In view thereof, opposer's third motion for leave to amend its pleadings is hereby granted, except as noted in the foregoing. Applicant is allowed until thirty days from the mailing date of this order to file an answer to those portions of the third amended notice of opposition that were not stricken hereby.

Turning to opposer's motion for summary judgment, opposer contends that there is no genuine issue of material fact to be resolved herein with regard to the claims that it has sought to raise by way of its third amended notice of opposition and that it is entitled to judgment as a matter of law. However, inasmuch as opposer has only been permitted to assert its claim that applicant has no bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#), the Board will consider opposer's motion for summary judgment with regard to that claim only.

As a preliminary matter, we turn to applicant's objection that opposer's exhibit Nos. 3-5, which consist of Internet printouts, are not properly before the Board because they are not supported by a declaration or affidavit. Printouts of material downloaded from the Internet cannot be considered self-authenticating so as to qualify for admission into evidence under [Trademark Rule 2.122\(e\)](#) for purposes of summary judgment. See [Raccioppi v. Apogee Inc.](#), 47 USPQ2d 1368 (TTAB 1998). Accordingly, applicant's objection is sustained, and those exhibits have not been considered in this decision. With regard to opposer's remaining exhibits, we note that applicant produced the materials contained therein in response to discovery requests. Accordingly, those exhibits are admissible for purposes of opposer's motion for summary judgment solely by attachment to that motion and have been accorded appropriate probative weight. See [Trademark Rule 2.127\(e\)\(2\)](#); TBMP Section 528.05(c).

***4** After reviewing the arguments and supporting papers of the parties, we conclude that opposer has not demonstrated the absence of a genuine issue of material fact for trial and that it is entitled to entry of judgment as a matter of law on its claim that applicant has no bona fide intent to use the mark in commerce.⁶ We note that exhibit Nos. 11-12 filed with opposer's motion for summary judgment show applicant's involved mark in use in commerce on goods identified in the application and that opposer has submitted advertising, sales, and promotional figures with regard to products and services with which the involved mark has been used or associated in the United States. Further, notwithstanding applicant's 1997 and 1998 discovery responses wherein it stated that it only intended to sell its recited goods under its mark in its retail stores, and subsequent responses that it has not operated its retail stores under the mark in Registration No. 2073848 since April 2002 and has sold only negligible amounts of the involved goods under the mark since that time, applicant is not precluded from adapting to changing market conditions with regard to its intended ways of selling its goods.⁷

In view thereof, opposer's motion for summary judgment is hereby denied.

Turning to opposer's motion for discovery sanctions under [Trademark Rule 2.120\(g\)\(1\)](#) for alleged failure to comply with the Board's June 26, 2002 order, in which opposer's motion to compel discovery was granted in part, we finds that sanctions are not warranted under these circumstances. After reviewing applicant's initial and supplemental discovery responses and the parties' arguments with regard to the motion for discovery sanctions, we are satisfied that applicant has not sought to evade its discovery obligations, but rather has made a good faith effort to provide the necessary responsive information and documents.⁸

In view thereof, opposer's motion for discovery sanctions under [Trademark Rule 2.120\(g\)\(1\)](#) is hereby denied.

Proceedings herein are resumed with discovery and trial dates reset as follows:

DISCOVERY PERIOD TO CLOSE: **6/1/04**

Plaintiff's thirty-day testimony period to close: **8/29/04**

Defendant's thirty-day testimony period to close: **10/28/04**

Plaintiff's fifteen-day rebuttal period to close **12/12/04**

***5** In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. [Trademark Rule 2.125](#).

Briefs shall be filed in accordance with [Trademark Rule 2.128\(a\)](#) and [\(b\)](#). An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

¹ Application Serial No. 74632112, filed February 9, 1995, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#). The application includes a disclaimer of any exclusive right to use TEXAS KIDS apart from the mark as shown and the following description: "The mark consists, in part, of the wording "TEXAS KIDS" and two, small circles forming the letters "TK" surrounding a star within a larger circle."

² Opposer's "family" of pleaded marks includes the following:
Registration No. 741662 for the following design mark



for “Canvas-Topped, Rubber-Soled Athletic Shoes” in International Class 25, issued December 4, 1962; Registration No. 924169 for CONVERSE and design in the following form

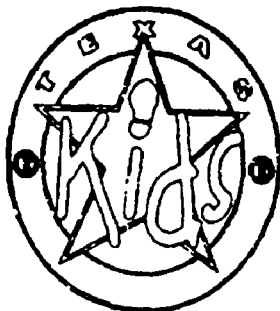


for “basketball shoes [and] general purpose athletic sneakers” in International Class 25, issued November 23, 1971; and Registration No. 1138469 for CONVERSE ALL STAR CHUCK TAYLOR and design in the following form



for “footwear” in International Class 25, issued August 5, 1980.

- 3 When issuing an order suspending proceedings pending disposition of a potentially dispositive motion, the Board ordinarily treats the case as if it had been suspended as of the filing date of the potentially dispositive motion. See *Leeds Technologies Limited v. Topaz Communications Ltd.*, 65 USPQ2d 1303 (TTAB 2002); TBMP Section 510.03(a). In keeping with that practice, the Board's August 12, 2003 suspension order is retroactive to April 25, 2003, the filing date of opposer's motion for summary judgment.
- 4 Registration No. 2073848 is for the mark TK TEXAS KIDS and design in the following form



for “retail store services featuring clothing, footwear and headwear for children, women, and men, gifts and accessories” in International Class 42, issued June 24, 1997. The registration includes a disclaimer of any exclusive right to use TEXAS KIDS apart from the mark as shown and the following description: “[t]he mark consists, in part, of the stylized lettering ‘TK’.” The registration was cancelled under Trademark Section 8, 15 U.S.C. Section 1058, on March 27, 2004.

- 5 Opposer bases its claim of abandonment on applicant's admissions that it has closed the last of its retail stores that operate under the mark shown in Registration No. 2073848 in April 2002. However, applicant's Registration No. 2073848 is subject of Cancellation

No. 92027599. Any allegations regarding the abandonment of applicant's mark with regard to its retail store services are properly raised in that cancellation proceeding.

In any event, we note that Registration No. 2073848 was cancelled under Trademark Act Section 8, [15 U.S.C. Section 1058](#), on March 27, 2004, and that, on March 30, 2004, the Board issued an order for applicant to show cause why the Board should not treat such cancellation as a surrender of the registration without opposer's consent and enter judgment against applicant under [Trademark Rule 2.134\(b\)](#).

- 6 A bona fide intent to use a mark in commerce merely requires an objective good faith intention to eventually use the mark in a real and legitimate commercial sense. See [H. Rep. No. 100-1028](#), 100th Cong, 2d Sess. (1988) with respect to the provisions of the Trademark Law Revision Act of 1988.
- 7 We note that the record indicates that applicant also renders retail store services under the PAPAGALLO CHILD mark. The fact that this proceeding remains pending justifies any limiting, discontinuation, or postponement of use of the involved mark on the involved goods for the time being. Cf. [Penthouse International Ltd. v. Dyn Electronics, Inc.](#), 196 USPQ 251 (TTAB 1977).
- 8 Opposer is reminded that, where information responsive to an interrogatory is not available, applicant is not required to speculate; likewise, where documents responsive to a request for production do not exist, applicant is not obligated to create them. See [Washington v. Garrett](#), 10 F.3d 1421, 1437-38 (9th Cir. 1993).

2004 WL 950919 (Trademark Tr. & App. Bd.)

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EXHIBIT F

2004 WL 882090 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

JEWELERS VIGILANCE COMMITTEE

v.

PIPER MANAGEMENT, INC.

Opposition No. 91150808

April 20, 2004

*1 Before Hanak, [Hairston](#) and [Bucher](#)
Administrative Trademark Judges

By the Board:

Piper Management, Inc. (“applicant”) seeks to register PLATINNIUM in typed form for platinum jewelry in International Class 14.¹

Jewelers Vigilance Committee (“opposer”) has opposed registration of applicant's proposed mark on the ground that the proposed mark is merely a novel spelling of “platinum,” a common misspelling of “platinum,” and therefore is generic for the composition of applicant's jewelry.

This case now comes up for consideration of (1) opposer's motion (filed October 27, 2003) to compel discovery; and (2) opposer's motion (filed November 18, 2003) for summary judgment in its favor on its claim of genericness. The motions have been fully briefed.²

The Board notes, as an initial matter with regard to the motion for summary judgment, that, as exhibits in support thereof, opposer has submitted printouts of the texts of 520 patents from the USPTO's Patent Full-Text and Image Database website and a third-party registration obtained from the USPTO's Trademark Electronic Search System which show descriptive use of the word “platinum,” allegedly as a misspelling of “platinum.” Applicant has objected to opposer's use of the patent printouts on the grounds that they are not identified by any exhibit numbers; that they are inadmissible hearsay; that they are incomplete, not certified, and not from the USPTO; and that they are not supported by any declarations; and that they “impose an intolerable burden” on both applicant and the Board. Applicant has also objected to opposer's submission of a copy of U.S. trademark Registration No. 2305033 on grounds that the copy is not certified and that it is irrelevant. In addition, applicant has objected to additional evidence submitted by opposer that was obtained from the Internet on the ground that such evidence is hearsay.

Opposer's reference in its brief in support of its motion for summary judgment to the 520 patent printouts and a copy of Registration No. 2305033 is sufficient, though barely, to identify the patents and registration as exhibits to that brief. See TBMP Section 528.05(b). Accordingly, applicant's objection that the printouts are not identified by exhibit numbers is overruled.

A party may make third-party registrations and, by analogy third-party patents, of record, for purposes of summary judgment only, by filing a copy thereof with its brief on the summary judgment motion; the copy need not be a certified copy, nor need it be a status and title copy. See TBMP Section 528.05(d). Although the patent printouts do not include the drawings that are part thereof, they include the complete texts thereof and are therefore acceptable as electronic equivalents thereof for purposes of

this motion. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Accordingly, applicant's objections that the patent and registrations printouts are neither certified copies nor supported by a declaration are overruled.³

***2** With regard to applicant's hearsay objections, the documents at issue are being submitted not to prove the truth of the statements made therein, but to show third-party use of "platinum" in a descriptive manner. See F.R.E. 801(c). As such, applicant's objection on the basis of hearsay is overruled.

With regard to applicant's objection that the submission of 520 patent printouts imposes an intolerable burden on applicant and the Board, we construe such objection as one that the probative value of the patent printouts is outweighed by their presentation of needless cumulative evidence under *Federal Rule of Evidence* 403. We note initially that the patent printouts at issue fill four boxes and create a stack of papers approximately four feet high. We further note that, while the word "platinum" is set forth in bold italics in each reference, some of the patent printouts are more than two hundred pages in length, and that opposer has not tagged, clipped, or otherwise directed the Board's attention to any of the specific pages on which the word "platinum" appears.⁴ Rather, opposer appears merely to have searched the USPTO's Patent Full-Text and Image Database for patents containing the word "platinum," printed the results of that search, and submitted the entire results without prioritizing, organizing, or numbering the printouts at issue.⁵ This sort of evidentiary dumping is unnecessary and unacceptable.

The Board finds that the submission of 520 patent printouts is needlessly cumulative and wasteful of the time and effort of the Board and the parties.⁶ See *Fed. R. Evid.* 403. Opposer should have limited its submission of patent printouts in support of its motion to the specific pages of a far smaller sample of patents that most directly support its arguments.⁷

In addition, a cursory review of the patent printouts indicates that they are minimally relevant to opposer's claim because the patents show use of the term "platinum" in contexts unrelated to jewelry.⁸ Accordingly, we find that the probative value of the 520 patent printouts is outweighed by their presentation of needless cumulative evidence. See *id.* Applicant's objection under *Fed. R. Evid.* 403 is sustained to the extent that we have considered only "Box 1" of the four boxes of patents printouts. With regard to opposer's remaining exhibits, we have considered them and accorded them appropriate probative weight.

Turning to the motion for summary judgment, after considering the parties' arguments and evidence in accordance with the foregoing, and resolving all reasonable inferences in applicant's favor, we find that there are genuine issues of material fact which preclude granting summary judgment for opposer on its genericness claim. At a minimum, genuine issues of material fact exist as to whether the relevant public understands the term "platinum" to be an alternate spelling of "platinium" and as to whether purchasers would perceive applicant's proposed mark PLATTINIUM as merely a novel spelling of that alternate spelling.⁹ See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 228 USPQ 528 (Fed. Cir. 1986); *In re State Chemical Mfg. Co.*, 225 USPQ 687 (TTAB 1985).

***3** In view thereof, opposer's motion for summary judgment is hereby denied.¹⁰

Turning to opposer's second motion to compel, the Board notes initially that the Board granted opposer's first motion to compel in a January 21, 2003 order and reset applicant's time to comply with that order in an August 25, 2003 order. In support of its second motion to compel, opposer contends that, applicant was required to supplement its responses to certain of opposer's discovery requests, including request for production No. 16; that, while applicant has indicated that responsive documents are available for inspection and copying at its place of business, applicant has produced only a single product tag in response to request for production No. 16. Accordingly, opposer asks that applicant be compelled to produce additional documents in response thereto and that it be allowed to take supplementary discovery in connection with those additional documents.

In response, applicant contends that opposer did not make a good faith effort to resolve the parties' discovery dispute prior to filing its motion to compel; that the product tag that it produced is used on all of its involved goods; and that the product tag

is the only responsive document that it has in its possession, custody and control. Accordingly, applicant asks that the Board deny opposer's second motion to compel.

The Board finds initially that opposer made a good faith effort to resolve the parties' discovery dispute before seeking Board intervention. See [Trademark Rule 2.120\(e\)\(1\)](#). However, applicant's response that the product tag that it already produced is the only document that it has in its possession, custody and control that is responsive to opposer's request for production No. 16 is acceptable.¹¹

In view thereof, opposer's motion to compel is hereby denied in all respects. Notwithstanding the foregoing, applicant is reminded that a party that has responded to a discovery request has an ongoing duty to supplement or correct that response. See [Fed. R. Civ. P. 26\(e\)](#). Applicant is further reminded that, when a party, without substantial justification, fails to disclose information required, or fails to amend or supplement a prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See [Fed. R. Civ. P. 37\(c\)\(1\)](#).

Proceedings herein are resumed. Discovery is closed. Trial dates are hereby reset as follows.

Plaintiff's thirty-day testimony period to close: **7/9/04**

Defendant's thirty-day testimony period to close: **9/7/04**

Plaintiff's fifteen-day rebuttal period to close **10/22/04**

***4** In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. [Trademark Rule 2.125](#).

Briefs shall be filed in accordance with [Trademark Rule 2.128\(a\)](#) and [\(b\)](#). An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

¹ Application Serial No. 76283584, filed July 9, 2001 and alleging June 4, 2001 as the date of first use and date of first use in commerce.

² Because opposer's reply brief in support of its motion for summary judgment clarifies the issues before us, that reply brief has received consideration. See [Trademark Rule 2.127\(a\)](#).

³ Applicant's objection that the patent printouts are not from the USPTO is not well-taken. Every one of the printouts clearly indicates at the top of its first page that it is taken from the USPTO Patent Full-Text and Image Database.

⁴ We note in addition that the word "platinum" frequently appears only once in a particular patent printout.

⁵ Opposer's only effort to direct the Board's attention to any specific patents that support its arguments was to quote from three patents in its brief. We note that opposer has not identified where in the mountain of exhibits that it submitted the printouts of the quoted patents are located. Inasmuch as we find that it is patently unreasonable to expect the Board to rummage through four boxes of unmarked, unorganized documents to find the printouts at issue, the Board has not considered them.

⁶ Opposer is reminded that the Board is an administrative tribunal that is empowered solely to determine the right to register marks. See Trademark Act Sections 17, 18, 20, and 24, [15 U.S.C. Sections 1067, 1068, 1070, and 1092](#).

⁷ Further, the better practice would have been for opposer to identify each patent printout by a separate exhibit number and to have submit an index of those exhibits.

⁸ For the same reason, Registration No. 2305033 is only minimally relevant to opposer's claim.

- 9 The fact that we have identified only two genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.
- 10 The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB (1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).
- 11 Applicant is not obligated to create responsive documents solely to satisfy opposer's discovery requests. See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993).

2004 WL 882090 (Trademark Tr. & App. Bd.)

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EXHIBIT G



GENERAL MOTORS CORPORATION v. ICRC -- INTEGRATED CONCEPTS &
RESEARCH CORP.

Opposition No. 91152661

Trademark Trial and Appeal Board

2005 TTAB LEXIS 125

March 9, 2005, Mailed

JUDGES: [*1]

Before Seeherman, Hanak and Chapman, Administrative Trademark Judges.

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

By the Board:

This proceeding comes up on opposer's motion (filed March 12, 2003) to compel and applicant's motion (filed May 14, 2003) for summary judgment. n1 The Board acknowledges the significant delay in addressing these motions and regrets any inconvenience to the parties caused by this delay.

n1 Opposer's motion (filed March 13, 2003) for entry of a protective order was withdrawn on April 7, 2003. The stipulated protective agreement (filed April 3, 2003) is noted.

The parties have briefed the motions. n2

n2 On June 5, 2003, opposer filed a motion for an extension of time to respond to the summary judgment motion. On June 13, 2003, applicant filed a paper wherein it consented to opposer's extension request but objected to opposer's submission of certain materials that were not timely produced during discovery. Opposer's motion to extend time is granted. Trademark Rule 2.127 (a). Applicant's objection is addressed later herein.

By way of background, we note the following.

On December 7, 2001, applicant filed an intent-to-use [*2] application (Serial No. 76346399) to register on the Principal Register the mark SMARTRUCK for "armored security vehicle for land use" in International Class 12 and "design and engineering services for development of armored security vehicles for others" in International Class 42.

Opposer filed a notice of opposition to registration of applicant's proposed mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052 (d), on the ground that applicant's mark, when used on or in connection with its identified goods and services, so resembles marks previously used by opposer, as to be likely to cause confusion,

mistake or to deceive. Specifically, opposer alleges, *inter alia*, that it has used "a family of SMART'-based names and marks in connection with its automotive and related business operations" since long prior to any priority date that applicant may claim; that "as early as October 1, 1988, General Motors, through its wholly-owned subsidiary General Motors Acceptance Corporation, adopted and has used continuously to [the] present the service mark SMARTLEASE by GMAC,' for Automobile Leasing Services,' as now registered on the Principal Register, [*3] Reg. No. 1,610,141, registered August 14, 1990"; that "as early as November 26, 1990, General Motors adopted and used the trademark SMARTTRACK' for combination all-wheel drive and four-wheel anti-lock braking systems for motor land vehicles,' as now registered on the Principal Register, Reg. No. 1,669,344, registered December 24, 1991"; that "as early as January 28, 1993, General Motors adopted and used the service mark SMARTDRIVE,' for providing financing services and extended warranty contract services for motor vehicles,' and providing repair services and roadside services for motor vehicles,' as now registered on the Principal Register, Reg. No. 1815311, registered January 4, 1994"; that opposer has "directly or through entities within which it is in privity, used other SMART'-based names and marks in connection with its automotive and other businesses for intervals of time prior to any date of priority which applicant may claim, including: (a) SMARTCHECK, for incentive program offering discount coupons to motor vehicle dealers,' first use: July 8, 1993; and (b) SMARTCHOICE, for motor vehicle leasing services,' first use: October, 1995"; that the dominant portion of applicant's [*4] proposed mark is the word "SMART" and its identified goods and services involve vehicles; and that opposer's "SMART-based marks and trade names in its automotive and related businesses, which so resemble the "SMART" mark of Application Serial No. 76/346,399, that use of the subject mark in connection with the goods and services identified in such application, is likely to cause confusion, or to cause mistake, or to deceive."

On October 7, 2001, applicant filed its answer acknowledging the existence of opposer's pleaded registrations but otherwise denying the remaining salient allegations in the notice of opposition.

We turn first to opposer's motion to compel. In response to the motion, applicant argues that the issues raised in opposer's motion to compel are moot in view of applicant's supplemental discovery responses which were served contemporaneously with the response to opposer's motion to compel. In a reply brief, opposer acknowledges receipt of applicant's supplemental discovery responses and states that all but one discovery dispute raised in the motion to compel has been resolved. Specifically, according to opposer, the one remaining area of disagreement involves applicant's [*5] response to opposer's interrogatory no. 7.

The subject interrogatory reads as follows:

Interrogatory No. 7

State and explain with factual details Applicant's position on duPont Factor No. 3, viz: The similarity or dissimilarity of established, likely-to-continue trade channels.

Applicant's initial response to this interrogatory repeated *verbatim* its previous responses to interrogatories 5-6 and does not respond in substance to the information requested. It reads as follows:

Applicant objects to Interrogatory No. 7 as being premature. Applicant further objects to Interrogatory No. 7 as seeking information which is not calculated to lead to the discovery of admissible evidence insofar as Opposer's Notice of Opposition contends that Opposer enjoys exclusive use of the term "Smart" in connection with automotive and related businesses as a result of numerous registrations referenced in the Notice of Opposition. Opposer has not identified any particular registration with which Applicant's trademark conflicts. Third-party uses of the term "Smart" in connection with automotive and related businesses renders Opposer's claim to exclusive rights to the term [*6] "Smart" for automotive and related businesses unlikely. Subject to its general objections and pursuant to Rule 33 (d) Applicant will produce documents concerning these other registrations and uses.

However, applicant filed a supplemental response which addresses the issue of similarity/dissimilarity of the trade

channels. It reads as follows:

Applicant has, and continues to, sell its SMARTRUCK products and offer SMARTRUCK services to U.S. Government agencies such as U.S. Army Tank -- Automotive and Armaments Command. The Applicant is working with third party O'Gara-Hess & Eisenhardt to determine if its goods and services can be marketed to a broader range of customers. Because of the nature of Applicant's goods, the potential buyers/market are somewhat limited to the U.S. Government/agencies. The Applicant's goods/services are sophisticated and specialized and its buyers (U.S. Government agencies) are likewise sophisticated and knowledgeable of their needs. It is highly unlikely any of these potential purchasers would reasonably believe the specialized design and engineering services and resulting armored security vehicles were offered/produced by the Opposer, even if the [*7] Opposer does have some marks incorporating the descriptive portion of the Applicant's mark, said services dealing with financial and leasing services for automobiles, dealer incentives, and a braking system. The Opposer may sell some vehicles to the government but its major purchaser is the ordinary buyer.

Opposer argues that applicant's response to interrogatory no. 7 is "still insufficient." Specifically, opposer states that "as a factual matter . . . applicant's supplemented answer is not well-supported" and that the supplemented response "proceeds from a false legal premise," inasmuch as applicant is "attempting to ignore its own application and rely on how its products are supposedly marketed in actual practice" instead of what is set forth in the application.

Upon review of the subject interrogatory and responses thereto, we find applicant's supplemental response to be sufficient for purposes of responding to the interrogatory. Essentially, opposer sought applicant's position regarding the *duPont* factor of trade channels and applicant stated its position in general terms. While opposer may disagree with the response and believe that the response is not "well-supported" [*8] or that it is "based on a false premise," a motion to compel is not an instrument for adjudicating the merits of a party's stated legal position as set forth in a discovery response. Accordingly, opposer's motion to compel a more complete response from applicant to its interrogatory No. 7 is denied. n3

n3 Although opposer's motion to compel is denied, for the sake of clarity, we note that opposer is correct in its argument that ultimately the issue of likelihood of confusion between the parties' marks will be determined based, in part, on an analysis of the goods and services recited in applicant's application, rather than what the evidence shows applicant's goods and services to be. See *Octocom Systems, Inc. v. Houston Computer Services, Inc.* 918 F.2d 937, 1 USPQ2d 1813 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."). *Id.* at 942.

[*9]

We now turn to applicant's motion for summary judgment and, as a preliminary matter, address applicant's objection to opposer's reliance on certain documents or materials submitted with opposer's opposition to the summary judgment motion. Specifically, applicant requests that the Board not consider certain documents and materials because they were not timely produced by opposer in response to applicant's discovery requests. Although applicant acknowledges that it received the materials prior to the filing of its summary judgment motion, it states that they were provided by opposer subsequent to the close of discovery and therefore asserts that they should not be considered.

Rule 26(e) of the Federal Rules of Civil Procedure provides that a party who has responded to a request for discovery is under a duty to supplement or correct the disclosure or response to include information thereafter acquired. This rule, therefore, contemplates that discovery disclosures may be made even after the deadline for responding to the initial discovery request, and that it is acceptable to make such supplemental responses. Applicant has not provided any basis [*10] for us to conclude that opposer deliberately refrained from serving these supplemental responses earlier, nor has applicant demonstrated any prejudice to it as a result of opposer's discovery responses not being produced earlier.

Accordingly, and inasmuch as applicant readily admits that it took the materials into consideration prior to filing the motion for summary judgment, the Board will consider all materials submitted by opposer in its opposition to the summary judgment motion.

We now turn to the substance of applicant's summary judgment motion. Applicant essentially argues that opposer does not own a family of SMART' marks; that opposer can not legally establish a family based on the surname SMART'; and that there is no likelihood of confusion in the marketplace between applicant's mark and any of opposer's individual SMART' marks.

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); and *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and [*11] any inferences which may be drawn from the underlying undisputed facts must be viewed in the light most favorable to the non-moving party. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

After reviewing the arguments and supporting materials of the parties, we conclude that there are genuine issues of material fact which preclude disposition of this matter by summary judgment. In particular, genuine issues of material fact exist as to whether opposer owns a family of marks, including whether the term SMART is capable of serving as a surname for a family of marks, and the degree of similarity/dissimilarity of the trade channels for the parties' respective goods and services. n4 In this connection, it is not opposer's burden, in responding to the motion for summary judgment, to establish that it has a family of "SMART" marks, only that there is a genuine issue as to whether it does not have such a family.

n4 The fact that we have identified these genuine issues of material fact as bases for denying the motion for summary judgment should not be construed as a finding that these are the only issues remaining for trial.
[*12]

In view thereof, and in accordance with Fed. R. Civ. P. 56, applicant's motion for summary judgment on the pleaded likelihood of confusion claim is denied. n5

n5 The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial periods. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Proceedings herein are resumed and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	May 16, 2005
30-day testimony period for party in position of defendant to close:	July 15, 2005
15-day rebuttal testimony period for the party in position of plaintiff to close:	August 29, 2005

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. [*13] Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128 (a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionConsumer ConfusionCircuit Court FactorsFederal Circuit CourtTrademark LawProtection of RightsRegistrationPrincipal RegisterTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGeneral Overview

EXHIBIT H

2004 WL 240313 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

CHESAPEAKE BANK

v.

CHESAPEAKE BANK OF MARYLAND

Opposition No. 91114353

Cancellation No. 92031763

February 5, 2004

*1 Before Simms, [Rogers](#) and [Holtzman](#)
Administrative Trademark Judges

By the Board:

On January 22, 2003, the Board suspended proceedings in Opposition No. 91114353 pending final disposition of the civil action between the parties in the United States District Court for the District of Maryland. Thereafter, on October 10, 2003, the Board resumed proceedings for consideration of opposer's motion for summary judgment and any related pending motions pursuant to a court order in the related civil action.

CONSOLIDATION

As a preliminary matter, it is noted that Opposition No. 91114353 and Cancellation No. 92031763 involve the same parties and common questions of law and fact. More specifically, defendant's mark in the opposition is CHESAPEAKE BANK and in the cancellation it is CHESAPEAKE. In both proceedings, plaintiff has alleged use of CHESAPEAKE and CHESAPEAKE BANK and claims ownership of two pending applications, Serial Nos. 75255515 and 75255517, for the mark CHESAPEAKE BANK all for use in connection with, inter alia, banking services. Further, in each case, both plaintiff and defendant intend to rely on use of other, arguably related marks. It is therefore appropriate to consolidate these two proceedings pursuant to [Fed. R. Civ. P. 42 \(a\)](#).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See, for example, [Wright & Miller, Federal Practice and Procedure: Civil §2383 \(1971\)](#); [Regatta Sport Ltd. v. Telux-Pioneer Inc.](#), 20 USPQ2d 1154 (TTAB 1991) (Board's initiative).

Accordingly, Opposition No. 91114353 and Cancellation No. 92031763 are hereby consolidated and may be presented on the same record and briefs. ¹

The Board file will be maintained in Opposition No. 91114353 as the "parent" case, but all papers filed herein must include the proceeding numbers of the consolidated cases, in ascending order.

Opposition No. 91114353 now comes before the Board for consideration of the following motions: (1) opposer's motion for summary judgment; (2) applicant's motion to amend its answer; (3) opposer's motion to supplement its summary judgment

motion; (4) applicant's motion to strike evidence submitted by opposer in support of opposer's motion for summary judgment; and (5) applicant's motion for judgment for fabrication and spoliation of evidence. The motions have been fully briefed.²

BACKGROUND

*2 Applicant filed an application for registration of the mark CHESAPEAKE BANK in typed form for “consumer banking services, namely, checking accounts, personal savings accounts, certificates of deposit, and loans secured by mortgages and automobiles” in Class 36.³ Opposer, in its notice of opposition, alleges likelihood of confusion under Section 2(d) of the Trademark Act with its marks CHESAPEAKE and CHESAPEAKE BANK. Applicant in its answer denies the salient allegations of the opposition. Proceedings were suspended for some time to facilitate settlement negotiations.

After resumption of proceedings, opposer filed a motion for summary judgment and applicant filed a motion for discovery under [Fed. R. Civ. P. 56\(f\)](#), to seek information on various instances of alleged actual confusion. Thereafter, the Board granted in part and denied in part applicant's subsequent motion to compel its requested 56(f) discovery and after several extensions of time the above-noted motions were fully briefed. The Board will address each motion in turn.

MOTION TO AMEND THE ANSWER

By its motion to amend, applicant seeks to add fourteen affirmative defenses. In support of its motion, applicant states that it will be prejudiced if not allowed to amend, as it would “make more difficult applicant's ability to defend against opposer's motion for summary judgment.” Further, applicant argues that opposer would not be prejudiced by the amendment because the “evidence in applicant's possession in support of its affirmative defenses was provided to opposer pursuant to opposer's discovery requests” and “additional evidence in support of applicant's affirmative defenses was and is in the possession and control of opposer.” Finally, applicant argues that it did not delay in bringing this motion because part of the amended answer includes a defense of unclean hands based on activity occurring during the proceeding and applicant was justified in waiting to assert its defense after completion of its investigation of particulars.

In opposition to the motion, opposer argues that applicant delayed too long in moving to amend and that granting the motion would be highly prejudicial to opposer “at this extremely late date in this opposition proceeding.” Opposer argues that applicant's amended answer increases the scope of discovery and discovery is already closed in this case.

[Fed. R. Civ. P. 15\(a\)](#) provides that leave to amend pleadings shall be freely given when justice so requires. In accordance with that principle, the Board liberally grants leave to amend pleadings where the other party will not be prejudiced thereby. *See Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) and *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974). However, undue delay in moving to amend may be prejudicial to the non-moving party. *See Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982). Moreover, where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

*3 Turning now to the affirmative defenses applicant seeks to add, we find that the allegations set forth in paragraph nos. 15-17, 19-21, and 26-27 serve to amplify the denials in the answer and apprise opposer with greater particularity of the position which applicant is taking in the defense of its right to registration, and allowance of the amplification will not prejudice opposer. With regard to paragraph no. 14 we find that allowance of the amendment would not be prejudicial to opposer because the registration recited in that paragraph is the subject of now consolidated Cancellation No. 92031763, in which opposer is the petitioner. With regard to paragraph no. 25, to the extent these allegations operate as an amplification of applicant's defense that there is no likelihood of confusion, it is allowed; however, applicant is advised that the determination of concurrent use rights is only available in a concurrent use proceeding involving a concurrent use application, or in a civil action before a district court. *See* TBMP Sections 1101.02, 1102.01, 1102.02. In view thereof, while the foregoing paragraphs in the proposed amended answer do not set forth true affirmative defenses, the motion to amend is granted as to paragraph nos. 14-17, 19-21, and 25-27.

With regard to paragraph no. 18, laches may not be asserted as a defense in an opposition proceeding.⁴ See *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

Paragraph no. 22 presents allegations regarding applicant's use of a domain name incorporating the term CHESAPEAKE BANK since July 1997 and asserts an estoppel defense. The only relevance applicant's use of the CHESAPEAKE BANK domain name would have is with regard to priority and because the filing dates of opposer's applications⁵ are earlier than the domain name registration, these allegations are immaterial. Paragraph no. 23 presents allegations regarding a third party's priority of use over opposer, which are also immaterial.

Paragraph no. 24 asserts the affirmative defense of unclean hands based on allegations pertaining to fabrication and spoliation of evidence by opposer during the course of this proceeding. Evidentiary matters, such as fabrication and spoliation, do not give rise to the affirmative defense of unclean hands. See *Vodusek v. Bayliner Marine Corp.*, 71 F.3d 148, 155-156 (4th Cir. 1995). The Board notes that these allegations are properly dealt with by applicant's motion for judgment, which we construe as a motion for a sanction for alleged misconduct engaged in during the course of this proceeding, which could include a sanction of judgment. In view thereof, the motion to amend is denied as to paragraph nos. 18 and 22-24.

MOTION FOR JUDGMENT

*4 In support of its motion for judgment, applicant alleges that opposer created false evidence of actual confusion and destroyed material evidence "that pertains directly to the creation of false evidence."⁶ It is applicant's contention that there is sufficient evidence to conclude that an e-mail sent by a customer of opposer, one Mr. Carlton Dunford, to applicant "was not an accident of confusion but instead an attempt to fabricate evidence of confusion" and that opposer's customer "willfully erased information on his computer hard drive...that would be essential to proving" that the e-mail was not an accident. In response, opposer states that applicant's allegations are "baseless" and that "applicant has presented no evidence whatsoever of either fabrication or spoliation."

Fabrication of evidence is a form of litigation misconduct that is subject to sanction up to and including judgment against a party. See *Vargas v. Peltz*, 901 F. Supp. 1572 (S.D. Fla. 1995); McCarthy, J. Thomas, *McCarthy on Trademarks*, Section 31:83 (4th ed. 2004).

"To establish spoliation the moving party must show that the adverse party had a duty to preserve the allegedly spoiled documents and that the documents were intentionally destroyed. The degree of culpability and the prejudice suffered by the moving party will guide a court in its formulation of remedial and punitive action." *Trigon Insurance Co. v. U.S.*, 204 FRD 277, 286 (E.D. Va. 2001). Under the spoliation of evidence rule, an adverse inference may be drawn against a party who destroys relevant evidence.

At issue here is a firestorm churned up around a single e-mail from one of opposer's customer's, Mr. Dunford, and addressed to applicant, but a message that had not been submitted by opposer as evidence in support of its motion for summary judgment. Rather, applicant brought the e-mail to opposer's attention and put it in the record here for purposes of supporting its Rule 56(f) motion for discovery. Now, applicant seeks to obtain judgment against opposer based on this e-mail and opposer seeks to rely on this e-mail in support of its summary judgment motion as an instance of actual confusion.

By way of background, on January 22, 2001 at approximately 8:00 pm, Mr. Dunford found the website with the domain name chesapeakebank.com and through that website sent an e-mail inquiring about tax information for his accounts. As it turns out, this website is for applicant's bank, not opposer's bank. One week later, on January 29, 2001, opposer filed its motion for summary judgment, which did not include this e-mail. Applicant brought this e-mail to opposer's attention in February 2001 and moved for and received time to conduct Rule 56(f) discovery into this e-mail.⁷ Thereafter, applicant moved to compel

the production of documents and witnesses in conjunction with its [Rule 56\(f\)](#) discovery requests. The Board, on January 28, 2002, granted applicant's motion in part and specifically compelled the depositions of two of opposer's employees and further responses to one document request and one interrogatory.

***5** Applicant was provided with ample opportunity to explore the circumstances surrounding this e-mail. As a result of its investigation, applicant's evidence of fabrication consists of the following: (1) two instances of allegedly contradictory accounts of certain facts appearing in the depositions of John H. Hunt, II, an officer of the opposer, and Mr. Dunford, regarding how Mr. Dunford found applicant's website and whether or not counsel for opposer was present during a February 2001 telephone conversation between Mr. Dunford and Mr. Hunt; and (2) Mr. Dunford's allegedly "contradictory and obviously self-serving testimony." With regard to Mr. Dunford's deposition, applicant essentially finds doubtful various choices made by Mr. Dunford in sending the e-mail (e.g., his taking a "shot in the dark" with the internet rather than remembering he has opposer's business card in his wallet which contains an e-mail address for one of the bank's employees)⁸ and attributes these acts to a conscious plan to use the e-mail as part of an effort to fabricate evidence of actual confusion.

Applicant's evidence of spoliation consists of statements made by Mr. Dunford regarding deletions of his e-mails from his personal computer. The Board notes in this regard that applicant's own statement of the law is not supported by the record. Applicant states that "when a party has notice...that evidence is necessary to the opposing party's claim, that party is under a duty not to take actions that would result in the destruction of the evidence" citing [Trigon Insurance Co. v. U.S.](#), 204 FRD 277, 287. Mr. Dunford, of course, is not a party and there is, in any event, no evidence his actions were taken at the behest of opposer. Also, based on Mr. Dunford's testimony, the relevant information would have been deleted prior to February 27, 2001, the date on which applicant charges both opposer and Mr. Dunford with knowledge that the computer evidence would be relevant to this litigation.

Q. Is that e-mail still on your computer?

A. No, it's not.

Q. What happened to it?

A. I erased it.

Q. And when did you erase it?

A. Probably 30 minutes after I got a reply back to the e-mail the next day [January 23, 2001], the next day or the day after that.

Dunford Deposition at 40 (December 3, 2001).

Q. How often do you empty out your [e-mail] trash.

A. Prior to all of this — I've got to clarify. Usually every time I would go in the e-mail, it could be once a day or once a week, but I keep it empty...I would do it [delete] every time I was online, just about as a habit to keep it cleaned up.

Dunford Deposition at 60.

It is Mr. Dunford's testimony that no one told him to send an e-mail to applicant and that he had no knowledge of any litigation between applicant and opposer until opposer's phone call to him sometime between March and May 2001, inquiring about the e-mail. Dunford Deposition at 132 and 11.

***6** Considering the severity of the accusations (e.g., "Mr. Dunford's conduct is certainly tortuous [sic], and could be considered criminal") the Board would expect applicant to produce clear evidence of misconduct. However, there is simply nothing in

this record on which to base a conclusion that evidence was fabricated or spoliated.⁹ In view thereof, applicant's motion for sanctions in the nature of judgment is denied.

MOTION TO SUPPLEMENT SUMMARY JUDGMENT MOTION

Opposer's motion to supplement its summary judgment motion with additional examples of alleged actual confusion is denied. The Board, in general, discourages piecemeal litigation and, moreover, [Trademark Rule 2.127\(a\)](#) provides that no further papers will be considered after the reply brief.

MOTION TO STRIKE

By this motion, applicant moves to strike twelve declarations and Exhibits I and J attached to Mr. Hunt's declaration. Applicant's arguments that the declarations are a "disguised survey" and that Exhibits I and J are "inadmissible compilations" are not well taken and the motion to strike is denied.

MOTION FOR SUMMARY JUDGMENT

Opposer has moved for summary judgment in its favor as to its Section 2(d) ground of opposition. The motion is granted in part and denied in part for the reasons set forth below.

Background/Pleadings

As noted above, applicant has filed an application for registration of the mark CHESAPEAKE BANK (in typed form) for "consumer banking services, namely, checking accounts, personal savings accounts, certificates of deposit, and loans secured by mortgages and automobiles" in class 36.

In its notice of opposition, opposer alleges, inter alia, that "since long prior to February 20, 1997,...opposer and its predecessors have used the designations CHESAPEAKE and CHESAPEAKE BANK in the United States as service marks in connection with banking services and related financial services," that "opposer is the owner of pending...applications serial nos. 75/255,515 and 75/255,517," that "applicant's services identified in its application are identical and/or closely related to opposer's banking services and related financial services and are sold or likely to be sold to the same classes of purchasers as opposer's services," and that applicant's "designation CHESAPEAKE BANK is identical to opposer's mark and is likely when applied to applicant's services to cause confusion or mistake or to deceive."

In its amended answer, applicant admitted the allegations concerning opposer's ownership of opposer's applications and their suspension by the Trademark Office. Further, applicant admitted that the marks are similar, and that "some of the services offered by the two parties overlap." Applicant denied the remaining allegations.

Summary Judgment Standard

*7 Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. [Fed. R. Civ. P. 56\(c\)](#). An issue is material when its resolution would affect the outcome of the proceeding under governing law. [Anderson v. Liberty Lobby, Inc.](#), 477 U.S. 242, 248 (1986). However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. *See, for example, Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.3d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). A fact is genuinely in dispute if the evidence of record is such that a reasonable fact finder could return a verdict in favor of the nonmoving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, including all inferences to be drawn from the undisputed

facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Parties' Evidence And Arguments

In support of its motion, opposer has presented evidence showing that: (1) opposer owns and is the prior user of the mark CHESAPEAKE BANK in connection with banking and related financial services; (2) opposer is the successor in interest to CHESAPEAKE BANKING COMPANY and CHESAPEAKE NATIONAL BANK; (3) the involved marks of opposer and applicant, CHESAPEAKE BANK, are identical; (4) the parties' services are virtually identical; and (5) opposer and opposer's predecessors in interest have continuously used the term CHESAPEAKE in combination with other terms, namely, they have used CHESAPEAKE BANKING COMPANY, CHESAPEAKE NATIONAL BANK and CHESAPEAKE BANK, beginning in 1920 and continuing through the present.

Opposer's evidence on summary judgment includes: (1) the declaration of John H. Hunt, II, opposer's senior vice president and chief financial officer, with accompanying exhibits; (2) copies of USPTO office actions suspending prosecution of opposer's application to register CHESAPEAKE BANK in view of the opposed application herein; (3) a copy of opposer's petition to cancel applicant's registration No. 2,301,218 for CHESAPEAKE; (4) the declarations of twelve of opposer's customers; (5) excerpts from applicant's answers to opposer's interrogatories; and (6) excerpts from opposer's depositions of applicant's officers R. Thomas Jefferson and Celeste Tolson.

*8 In response, applicant's evidence includes: (1) the declaration of R. Thomas Jefferson, applicant's president, with accompanying exhibits; (2) excerpts from the deposition of John H. Hunt, II, taken on March 7, 2002; and (3) excerpts from opposer's answers to applicant's interrogatories.

Opposer argues, inter alia, that the marks are identical, the services are identical, the trade channels are identical, the services are purchased by the same class of purchasers, there has been actual confusion, opposer is the prior user of the mark CHESAPEAKE BANK and opposer is the prior user of the term CHESAPEAKE in connection with banking services through use by its predecessors in interest of the designations CHESAPEAKE BANKING COMPANY from 1920 to 1967 and CHESAPEAKE NATIONAL BANK from 1967 to 1994.

In response, applicant argues, inter alia, that opposer's parent, a non-party, is the owner of the mark CHESAPEAKE BANK, that opposer is not in any event the senior user, in view of applicant's use of the mark CHESAPEAKE since 1960 and the change in commercial impression occurring each time opposer's predecessors changed names, and that opposer is not the successor in interest to any trademark in use prior to 1994.¹⁰

We note that applicant does not dispute that the involved marks [CHESAPEAKE BANK] are identical, that the parties offer overlapping services, and that opposer first used the mark CHESAPEAKE BANK in 1994.

Decision

In determining whether there is any genuine issue of material fact relating to the legal question of likelihood of confusion, the Board must consider all of the probative facts in evidence which are relevant to the factors bearing on likelihood of confusion, as identified in *In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As noted in the *du Pont* decision itself, various factors, from case to case, may play a dominant role. *Id.*, 476 F.2d at 1361, 177 USPQ at 567. Those factors as to which we have probative evidence are discussed below.

We find that there is a likelihood of confusion as to the marks CHESAPEAKE BANK. The evidence of record clearly establishes the lack of a genuine issue of material fact as to the identical nature of the marks CHESAPEAKE BANK and CHESAPEAKE

BANK. As to the services offered by each party, the evidence of record shows that opposer offers banking services and related financial services under the CHESAPEAKE BANK mark, see e.g., John Hunt Declaration Exh. E, and applicant's identified services are "consumer banking services, namely, checking accounts, personal savings accounts, certificates of deposit and loans secured by mortgages and automobiles." These services are virtually identical.

Regarding the channels of trade, the involved application is unrestricted. Thus, the Board must presume that applicant's services are marketed or will be marketed in all the normal channels of trade for the identified services and to all the usual classes of purchasers of such services. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed Cir. 1992).

*9 In addition, opposer's uncontroverted evidence of prior use of CHESAPEAKE BANK establishes both opposer's prior use of CHESAPEAKE BANK and opposer's standing in this case. Further, we find that opposer is the owner of the mark CHESAPEAKE BANK.¹¹ No genuine issue of material fact exists on any of these issues.

We find that there are no genuine issues of material fact relating to opposer's standing and to the *duPont* likelihood of confusion factors, and we hold that opposer is entitled to partial summary judgment on the question of likelihood of confusion, such question being limited in the opposition to a comparison of the respective CHESAPEAKE BANK marks. On the other hand, while we find no genuine issue regarding opposer's prior use of CHESAPEAKE BANK, per se, we find that opposer is not entitled to judgment in its favor on the overall legal issue of priority, as presented in the opposition. There are factual¹² and legal¹³ issues relating to which party was the first to acquire rights in the term CHESAPEAKE alone and whether such rights are or could be derived from a use of CHESAPEAKE with another descriptive or generic term. Thus, the motion for summary judgment is granted as to likelihood of confusion and denied as to priority.¹⁴

CIVIL ACTION/CONCURRENT USE

The Board notes that applicant has asserted that the parties "operate in geographically distinct markets." In the context of these consolidated proceedings, the "geographical separation of the parties' principal places of business cannot be considered to be of significance in determining registrability of applicant's mark since it seeks a geographically unrestricted registration." *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In short, there is no concurrent use application before the Board, and the Board will not consider concurrent use rights in the absence of a proper concurrent use application and a concurrent use proceeding. Moreover, with regard to the application involved in the opposition, applicant may not move to amend its application to one seeking concurrent use based on geographic restrictions because the application was filed under Section 1(b) of the Trademark Act based on intent to use. See TBMP Section 1103.01 (2d ed. June 2003). As to applicant/respondent's registration for the term CHESAPEAKE, this could be subject to geographic restriction either by way of court order or by way of a concurrent use proceeding precipitated by a concurrent use application by opposer naming this registration as an exception to opposer's rights.

With this in mind, the Board reiterates that the issue of any respective concurrent use rights is, at this time, more properly considered by the district court in the civil action.

SUSPENSION

Inasmuch as the July 8, 2003 order of the United States District Court of Maryland stayed proceedings in the civil action for the sole purpose of the Board ruling on the summary judgment motion and the motion having now been disposed of, proceedings herein are suspended pending disposition of the civil action between the parties. In the event the court stays the civil action, the Board will resume these consolidated proceedings, including time for discovery,¹⁵ and proceed to trial.

*10 ***

1 The parties are reminded that because the Board has ordered the consolidation of the above-identified proceedings, they should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties.

2 Applicant's consented motions filed on April 25, 2002 and May 13, 2002 and opposer's consented motions filed on June 14, 2002 and July 1, 2002 to extend various response times are granted.

3 Application Serial No. 75244844 filed on February 20, 1997 and claiming a bona fide intent to use the mark in commerce.

4 Moreover, to the extent applicant seeks to present a "Morehouse" defense, *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969), this defense is unavailable to applicant inasmuch as opposer has petitioned to cancel the registration upon which defendant is relying. See *Estate of Ladislao Jose Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

5 Applications Serial Nos. 75255515 and 75255517 filed March 11, 1997.

6 In view of our decision *infra* regarding opposer's motion to supplement the summary judgment motion, applicant's motion is arguably moot inasmuch as the allegedly fabricated evidence in question is not evidence of record. However, in order to put this matter to rest the Board takes up the motion on its merits.

7 Applicant found the proximity of the transmission of the e-mail and the filing of the motion for summary judgment suspicious. Opposer agreed to allow discovery on the subject, stating "opposer is happy to let applicant develop evidence of actual confusion against itself." Opposer's Brief (April 23, 2001) at 5.

8 Q. And rather than wait until the next day to find out or make a call, and rather than check to make sure, since you had a card in your pocket, you went ahead and sent it anyway? A. Correct. Dunford Deposition at 138 (December 3, 2001).

9 In this regard, applicant's attorney is advised that the Board may through its inherent authority sanction parties that increase the cost of litigation by filing frivolous motions. *Central Mfg. Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210 (TTAB 2001); *Carrini, Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067 (TTAB 2000). See also, *Chambers v. NASCO, Inc.*, 501 U.S. 32, 111 S.Ct. 2123, 115 L.Ed.2d 27, rehearing denied, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097 (1991).

10 As discussed supra, applicant's arguments based on laches and the Morehouse defense are unavailable to applicant and have been given no consideration.

11 With regard to the ownership issue applicant seems to argue that because opposer is wholly-owned and controlled by a parent corporation, it is the parent corporation that is the owner of the mark. This argument is without merit. Under the "unity of control" doctrine, either the parent or the subsidiary may be the proper owner of the mark regardless of which one is the controlling entity as long as one of them controls the other. With regard to applicant's arguments regarding the parent subsidiary relationships applicant is directed to *In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987), rev'd on other grounds, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988) and TMEP Section 1201.07.

12 At a minimum, genuine issues of fact remain as to: (1) which party first used the term CHESAPEAKE by itself and the extent of that use, insofar as it may have given rise to service mark rights; and (2) any continuing commercial impression created by the parties' respective uses of their names and/or service marks. See *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). The issues of fact relating to continuing commercial impression include not only the similarity of the marks, but also the context of their use, and customer perception. Applicant's change from using CHESAPEAKE in connection with "federal savings and loan" to using it in connection with "bank" may "convey more information to potential customers" thus creating a different commercial impression, whereas opposer, referred to consistently as a bank of some type or banking company, may have created a single, continuing commercial impression, notwithstanding differences. *American Security Bank v. American Security & Trust Co.*, 571 F.2d 564, 197 USPQ 65 (CCPA 1978); *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036 (TTAB 1989), *aff'd*, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990).

13 The question remains as to the appropriate tacking standard to apply: prior use of the salient feature of a trade name, as in *Bionetics Corp. v. Litton Bionetics, Inc.*, 218 USPQ 327 (TTAB 1983), or prior use of a trademark legally equivalent to a current mark, as in *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036. We decline to rule on this question of law because the parties may not have realized its potential importance and did not fully brief the question.

- 14 The parties are advised that our decision granting partial summary judgment is interlocutory in nature. The time for seeking judicial review thereof shall expire two months from the date of a final decision in this opposition proceeding. See [Trademark Rule 2.145\(d\)](#); and *Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1988). Further, the parties are reminded that any evidence submitted in support of or opposition to a summary judgment motion is only considered of record for the purposes of that motion. See TBMP Section 528.05(a). If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record and will not be considered at final hearing unless it is properly introduced in evidence, during the appropriate trial period.
- 15 In keeping with Board practice dates would be reset to coincide with the latest instituted proceeding.

2004 WL 240313 (Trademark Tr. & App. Bd.)

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